

BULKY DOCUMENTS

(exceeds 300 pages)

Proceeding/Serial No: 911661373

Filed: 01-30-2006

Title: Applicant's Motion for Summary
Judgment

Part 3 of 3

IV. CONCLUSION

The phrase "America's Favorite Pasta" is a subjective, self-laudatory statement made on behalf of the MUELLER'S brand. NWP's arguments and "Proofs" which seeks to establish false advertising as a matter of law fail utterly. In the context of a false advertising charge between intense commercial rivals, for NWP to survive AIPC's motion to dismiss, let alone to prevail on the motion for summary judgment, much more evidence would be needed. The motion should be dismissed.

Respectfully submitted,

AMERICAN ITALIAN PASTA COMPANY

Dated: November 13, 2002

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The undersigned hereby certifies that I electronically filed Plaintiff's AMERICAN ITALIAN PASTA COMPANY'S SUGGESTIONS IN OPPOSITION TO NEW WORLD PASTA'S MOTION FOR PARTIAL SUMMARY JUDGMENT with the Clerk of the Court for the Western District of Missouri using the CM/ECF system which sent notification of such filing to Brent Coverdale (bcoverdale@shb.com) of Shook, Hardy & Bacon L.L.P., One Kansas City Place, 1200 Main Street, Kansas City, MO 64105-2118; Forrest A. Hainline III (aikidolaw@aol.com), Suite 440, 5335 Wisconsin Avenue, N.W., Washington, D.C. 20012 and I hereby certify that I have e-mailed the documents to the following non CM/ECF participants:

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EXHIBIT K

FOR THE WESTERN DISTRICT OF MISSOURI

AMERICAN ITALIAN PASTA COMPANY,)
)
Plaintiff,)
)
v.) Civil Action No. 02-0594-CV-W-SOW
)
NEW WORLD PASTA COMPANY,)
)
Defendant.)

**MEMORANDUM IN SUPPORT OF AMERICAN ITALIAN PASTA COMPANY'S
MOTION TO DISMISS DEFENDANT NEW WORLD PASTA COMPANY'S
COUNTERCLAIMS UNDER FED. R. CIV. P. 12(B)(6)**

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**ECF
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I hereby attest and certify this is a printed copy of a
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I. INTRODUCTION

New World Pasta, Inc. ("New World") has counterclaimed in this action alleging false advertising. New World seeks to prevent its competitor, American Italian Pasta Company ("AIPC"), from using the slogan "America's Favorite Pasta" in connection with the marketing of its products. However, consideration of the pleadings shows that New World is improperly attempting to recast the slogan and thereby restrain AIPC from conducting legitimate marketing activities. There is no legal basis to restrict AIPC from using its slogan.

Contrary to New World's conclusory legal allegations and unwarranted deductions of fact, the slogan "America's Favorite Pasta" is not a literally false or implicitly misleading statement of fact. The slogan is opinion or mere "puffery" that is not susceptible to testing, quantification, or measurement. In particular, "America's" does not equate to sold throughout the United states and the word "favorite" does not mean "best selling." The slogan taken as a whole is too generalized to be false or misleading. This Court may determine the meaning of advertising slogans on the pleadings. "America's Favorite Pasta" is not actionable as a matter of law.

Notwithstanding that the Lanham Act provides a uniform, national remedy for false advertising, New World has also alleged violation of seventeen different state statutes, each of which raises various distinct legal issues under the laws of the seventeen different states. As a common thread, however, AIPC's use of the slogan must be "unfair" and by applying the same reasoning as for the Lanham Act claims, such use by AIPC is clearly not actionable. In any event, in view of the fact that AIPC's slogan is not actionable under the Lanham Act and there is no federal question, the Court should exercise its discretion and dismiss the supplemental state claims.

Independent of the Court's determination under the Lanham Act, New World as a competitor lacks standing to sue under Maryland and New Jersey law and the Court should dismiss counts eight and eleven.

Even when all of New World's *factual* allegations are accepted as true, New World can not prevail as a matter of law on its Lanham Act Claim. It is appropriate in these circumstances for the Court to exercise its discretion and to dismiss the state law claims. This Court may thus terminate, at an early stage, New World's use of this litigation as a business tactic.

II. RELEVANT NEW WORLD ALLEGATIONS

AIPC is not seeking to challenge the factual allegations at this stage of the proceedings, nor does it seek to introduce new matters for the Court's consideration. Those are not proper matters for motions under Federal Rule of Civil Procedure 12(b)(6). However, AIPC invites the Court's attention to some particular aspects of the pleadings.

A. Uncontested Factual Allegations Made by New World.

In paragraph 4 of its counterclaim, New World states that "New World Pasta is the number one branded pasta manufacturer in the United States [selling] its products in all 50 states." It would appear that New World is claiming to currently have the highest quantity pasta sales in the United States. Similarly, in paragraph 5 of the counterclaim, New World apparently alleges that the Mueller's brand enjoys only the second highest quantity of pasta sales.

In paragraph 5 of its counterclaim, New World alleges that Mueller's pasta is currently not available in "large sections of the United States, including many of the Eastern States." In paragraph 8 of its counterclaim, New World alleges that Mueller's pasta is not sold "at all anywhere [w]est of the Mississippi [River]."

In paragraph 6 of its counterclaim, New World alleges that AIPC purchased the Mueller's brand from Best Foods in November of 2000. In the same paragraph, New World apparently alleges that prior to the transfer to AIPC, Mueller's had the highest quantity pasta sales in the United States. Next, New World alleges that subsequent to the purchase of the Mueller's brand, the brand's quantity

sales ranking changed. According to New World, Mueller's no longer enjoys the highest quantity sales of pasta in the industry. For the purposes of this motion *only*, none of these allegations are in dispute.

In paragraph 15, New World alleges that it sells its pasta in direct competition with Mueller's. New World and AIPC clearly agree that they are competitors in the pasta industry.

B. New World Allegations Amounting to Unreasonable Inferences Or Unwarranted Deductions of Fact.

In paragraphs 8 and 9 of its complaint, New World repetitively states essentially the same allegation, that "AIPC's advertising claim 'America's Favorite Pasta' falsely conveys to consumers that Mueller's is a national brand of pasta, and is the number one selling pasta in the country." New World makes no subsidiary factual allegations to support these conclusions, but rather relies merely on these bald statements. As described below, the Court need not accept unreasonable inferences or unwarranted deductions of fact.

C. New World's Legally Conclusory Allegations

In paragraph 8 of its counterclaim, New World makes the legally conclusory statement that "America's Favorite Pasta" is literally false. In paragraph 9 of its counterclaim, New World sets forth the legally conclusory non-sequitur that because Mueller's is allegedly only the second highest selling pasta, the slogan "America's Favorite Pasta" is somehow misleading.

In paragraph 14 of its counterclaim, New World states the legal conclusion that the slogan "America's Favorite Pasta" misrepresents the nature, characteristics, and/or qualities of Mueller's pasta. In paragraph 16 of its counterclaim, New World presents the ultimate legal conclusion that use of the slogan "America's Favorite Pasta" somehow violates section 43(a) of the Lanham Act. In the remaining paragraphs of its First Claim, New World states the legal conclusions that it is entitled to damages, an injunction, attorney's fees and costs.

III. ARGUMENT

A. The Standard for Relief Under Fed. R. Civ. P. 12(b)(6)

This is a motion for failure to state a claim upon which relief can be granted pursuant to Federal Rule of Civil Procedure 12(b)(6). A claim should not be dismissed on a motion under Fed. R. Civ. 12(b)(6) unless it appears beyond a reasonable doubt that the nonmoving party can prove no set of facts that would entitle it to relief. *Young v. City of St. Charles, Mo.*, 244 F.3d 623, 627 (8th Cir. 2001); *Breedlove v. Earthgrains Baking Cos., Inc.*, 140 F.3d 797, 799 (8th Cir. 1998); *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957). For the purposes of a motion for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6), the Court must accept material factual allegations in the complaint as true and construe them in the light most favorable to the nonmoving party. *Young*, 244 F.3d at 627.

A court, however, need not assume the truth of the nonmoving party's legally conclusory statements merely because they are presented as factual allegations. See *Hiland Dairy, Inc. v. Kroger Co.*, 402 F.2d 968, 973 (8th Cir 1968); see also *Lee v. City of Los Angeles*, 250 F.3d 668, 679 (9th Cir. 2001) ("Conclusory allegations of law . . . are insufficient to defeat a motion to dismiss"); *Young*, 244 F.3d at 627 ("To avoid dismissal, a complaint must allege facts sufficient to state a claim as a matter of law and not merely legal conclusions."). Further, "unreasonable inferences or unwarranted deductions of fact" may not be assumed in deciding a motion to dismiss. *Hiland Dairy*, 402 F.2d at 973. If the alleged facts as presented in the pleadings of the nonmoving party undermine the legal theory presented by the nonmoving party, the court may consider the alleged facts as presented in the pleadings. See e.g. *Wood v. Department of Labor*, 275 F.3d 107, 110 (D.C. Cir. 2001).

A motion to dismiss that presents facts outside of the pleadings should be treated as a motion for summary judgment. Fed.R.Civ.P. 12(b). However, "[f]acts outside the pleadings susceptible

to judicial notice . . . do not mandate treating a motion to dismiss as a motion for summary judgment.” *In re Century 21-RE/MAX Real Estate Adver. Claims Litig.*, 882 F.Supp. 915, 921 (C.D.Cal. 1994).

B. Lanham Act Elements

1. False Advertising Under 15 U.S.C § 1125(a).

New World's first claim for relief alleges a violation of section 43(a) of the Lanham Act, 15 U.S.C § 1125(a). A plaintiff must prove the following elements in order to establish that a claim of another is false or deceptive advertising under the section 43(a) of the Lanham Act:

1. a false statement of fact was made by the defendant in a commercial advertisement about its own or another product;
2. the statement actually deceived or has the tendency to deceive a substantial segment of its audience;
3. the deception is material, in that it is likely to influence the purchasing decision;
4. the defendant caused its false statement to enter interstate commerce; and
5. the plaintiff has been or is likely to be injured as a result of the false statement, either by direct diversion of sales from itself to defendant or by a loss of goodwill associated with its products.

United Indus. Corp. v. Clorox Co., 140 F.3d 1175, 1180 (8th Cir. 1998).

2. Courts Can Determine Whether Statements Are Literally False As a Matter of Law.

In paragraph 8 of its counterclaim, New World states the legal conclusion that “America's Favorite Pasta” is a factual assertion which is literally false. Literal falsity of an advertisement is relevant to the first two elements of a section 43(a) violation. *In re Century 21*, 882 F.Supp. at 922. A showing of literal falsity satisfies the first element that a false statement was made, and excuses the claimant from proving impact on the public, which is presumed in the case of literally false statements. *Id.*

Courts determine whether an accused statement is literally false without considering factual issues about public perception of the statement. *See United Indus. Corp.*, 140 F.3d at 1180.

Furthermore, ambiguous statements cannot be literally false. *In re Century 21*, 882 F.Supp. at 923., citing *Coors Brewing Co. v. Anheuser-Busch Cos., Inc.*, 802 F.Supp. 965, 969 (S.D.N.Y.1992).

3. *Implicitly False Or Misleading Statements*

A statement of fact that is not literally false may still be implicitly false, if it is misleading. *United Indus. Corp.*, 140 F.3d at 1182. A determination of implicit falsity requires either proof of willfulness or actual material misleading of consumers. *Id.* at 1183. However, if a court makes the legal determination that a statement is not literally false, a claim of implicit falsity will not defeat a motion to dismiss if the statement constitutes mere “puffery,” because puffery is not actionable. *See United Indus. Corp.*, 140 F.3d at 1180. As set forth below, the determination of whether an advertisement constitutes mere puffery is a matter of law for the court to decide. *In re Century 21*, 882 F.Supp. at 926. Moreover, only facts, not opinions, are actionable. “Section 43(a) makes actionable any false or misleading description *of fact*, or false or misleading representations *of fact*. It does not impose liability for mere expressions of opinion.” J. Gilson, Trademark Protection and Practice, § 5.10 [3][b], 2001.

4. *Courts May Determine Whether Statements Constitute Non-Actionable Puffery As a Matter of Law.*

“Puffery is exaggerated advertising, blustering, and boasting upon which no reasonable buyer would rely and is not actionable under § 43(a).” *United Indus. Corp.*, 140 F.3d at 1180 (internal quotations omitted). Courts have also characterized puffery as “representations of product superiority that are vague or highly suggestive.” *United Indus. Corp.*, 140 F.3d at 1180.

Because of their generalized nature, ads that fall into the category of “puffery” do not meet the first and second elements required under § 43(a) because “it is beyond the realm of reason to assert . . . that a reasonable consumer would interpret [the puffery] as a factual claim upon which he or she

could rely. *In re Century 21*, 882 F.Supp. at 926, citing *Cook, Perkiss, & Leihe, Inc. v. N. Cal. Collection Serv.*, 911 F.2d 242, 245 (9th Cir. 1990).

C. New World Cannot Show the Slogan America's Favorite Pasta Is Literally False Or Implicitly Misleading; It Is Merely Puffery.

1. The Slogan "America's Favorite Pasta" Is Not Literally False.

To sustain its claim for false advertising under Section 43(a), the plaintiff must show that AIPC's use of the slogan "America's Favorite Pasta" in connection with its Mueller's pasta products is somehow a false or misleading description or misrepresentation of fact regarding the nature, quality, or geographic origin of defendant's goods. 15 U.S.C. § 1125(a)(1)(B). The facts as alleged by New World, even if viewed in a light most favorable to New World, fall short of the required proof.

As a matter of law, an ambiguous statement cannot be literally false. *In re Century 21*, 882 F.Supp. at 923. On its face, each constituent word of the slogan "America's Favorite Pasta" is ambiguous. Webster's Third New International Dictionary, at page 68, defines the adjective "America" as "of or from North America or South America" or "the kind or style prevalent in North America or South America." "America's" may be intended merely as a statement meant to invite feelings of patriotism. Does "America's" mean the United States government or other non-natural persons therein? It could mean a plurality or majority of people or merely a representative segment thereof. "America's" could refer to everyone in North and South America. It might mean only those people in North America. Or perhaps as New World would suggest, it means only the people in the 49 States that are located in North America, plus Hawaii.

The term "favorite" is also ambiguous. Contrary to New World's apparent understanding, "favorite" is not a ranking that can only be applied to the top item in a category. A person may have several favorite colors, restaurants, or memories. The Court is invited to take judicial notice of any

dictionary definition of the word "favorite." For example, Webster's defines "favorite" as "regarded with particular favor or preference." Webster's Universal College Dictionary 293 (1997). An individual may have several competing favorite items, such as competitors' branded items, that he regards with favor. Each would be a favorite.

Additionally, the term "pasta" is, itself, ambiguous. The Court is invited to take judicial notice that there are many different kinds of pasta: such as macaroni, spaghetti, lasagna, capellini, fettuccine, linguine, long fusilli, and vermicelli, just to name a few. Even if not ambiguous, there is no assertion that Plaintiff's products are not pasta.

When taken in combination, the slogan "America's Favorite Pasta" is at least as ambiguous as its constituent parts. The slogan, at most, conveys a general notion that associated products enjoy a vaguely defined preference by an undefined group of people. It certainly does not carry a specific and established meaning constituting a specific claim of fact as to properties or characteristics on which the public would rely in making a purchasing decision. Because of the slogan's vague and generalized nature, it simply cannot be literally false. The slogan is one that no reasonable consumer would rely on.

2. *The Slogan "America's Favorite Pasta" Is at Most Mere Puffery.*

Failing the literal falsity test, New World must prove that the slogan is actually misleading. *United Indus. Corp.*, 140 F.3d at 1180. However, by their very nature, some statements are so subjective that they can not be classified as false or misleading. Accordingly, under Eighth Circuit Lanham Act jurisprudence, statements that are determined to constitute puffery are not actionable. *Id.*

Mere puffery includes advertisements that do not contain factual assertions, because either the statements are not susceptible to verification, or purchasers are not likely to rely on the statements. For example in the *In re Century 21* case, the court held that the phrase "RE/MAX #1 in the United

States – and the World” amounted to nothing more than “classic puffery.” *Id.* at 928. It explained that the advertisement made no specific factual claim and was nothing more than an opinion because it made no reference to the category in which RE/MAX was number one. *Id.* By contrast, it held that the statement “RE/MAX agents outsell other real estate agents 3 to 1” was a specific factual assertion that did not constitute mere puffery and was, therefore, potentially actionable. *Id.* at 926.

Here, just as in *Century 21*, the slogan “America's Favorite Pasta” makes no reference to any category or metric under which Mueller's is preferred. New World is trying to fit it into the category of highest quantity of current sales. But, for the mere slogan or opinion expressed, no categorization is necessary or even appropriate, nor is such a slogan a statement of fact capable of measurement. Nothing about the slogan “America's Favorite Pasta” implies that any arbitrary metrics should be used to evaluate the slogan. Like the nonactionable statement by RE/MAX about being “#1,” “America's Favorite Pasta” makes no reference to any category for establishing what specifically is whose favorite.

The determination of whether particular language in an advertisement constitutes puffery is a matter of law, which is, therefore, appropriate for determination on a motion to dismiss for failure to state a claim. *See e.g. Cook, Perkiss, & Leihe, Inc.*, 911 F.2d at 245; *In re Century 21*, 882 F.Supp. at 926.

The facts are undisputed. AIPC uses the slogan “America's Favorite Pasta” on its Mueller's brand pasta. For the purpose of this motion *only*, APIC does not dispute whether New World or others currently have the brand with the highest quantity of pasta sales in the United States. However, as a matter of law, the generalized statement “America's Favorite Pasta” like all “classic puffery” is nothing more than highly subjective blustering or boasting.

Further, the composite slogan “America's Favorite Pasta” is not subject to verification. Apart from an opinion expressing merely that people in America like it, it also suggests that it is a style

of pasta which is preferred by Americans. Accordingly, "America's Favorite Pasta" is merely a generalized slogan and not a statement of fact that is susceptible to verification. As a matter of law, "America's Favorite Pasta" is at most mere puffery. *Cf. Best Buy Warehouse v. Best Buy Co., Inc.*, 751 F.Supp. 824, 826 (W.D. Mo. 1989) *aff'd* 920 F.2d 536 (8th Cir. 1990)(where this Court stated that "best" and "buy" were defined in the dictionary and that these terms were nothing more than sales puffing).

Because AIPC's use of "America's Favorite Pasta" in connection with its Mueller's pasta amounts to nothing more than mere puffery, as a matter of law, it cannot constitute false advertising, and New World Pasta's counterclaim must be dismissed.

3. *New World's Unsupportable Allegations that AIPC's Slogan Falsely Conveys Nationwide Sales and Number One Selling in the Country Cannot As a Matter of Law Sustain Its Claim.*

New World alleges that "America's Favorite Pasta" conveys that Muellers is a national brand and is best selling in the nation. However "unreasonable inferences or unwarranted deductions of fact" may not be assumed in deciding a motion to dismiss. *Hiland Dairy*, 402 F.2d at 973. "[A] reviewing court need not swallow [the non-moving party's] invective hook, line, and sinker; bald assertions[,] unsupportable conclusions, periphrastic circumlocutions, and the like need not be credited." *Mass. School of Law at Andover v. American Bar Association*, 142 F.3d 26, 40 (1st Cir. 1998) (internal quotations omitted); *Thayer v. Dial Indus. Sales, Inc.*, 85 F.Supp.2d 263, 268 (S.D.N.Y. 2000) (Court rejected allegation of contractual ambiguity stating "legal conclusions masquerading as factual conclusions will not suffice to prevent a motion to dismiss").

Interpretation of the meaning of an advertisement is properly determinable as a matter of law. *In re Century 21*, 882 F.Supp. at 926 ("[j]ust as a court can look at the face of an advertisement and decide as a matter of law whether the ad constitutes puffery, a court may also determine the meaning of an ad on its face with no reliance on extrinsic evidence"). Thus, the Court may decide as a matter

of law whether "America's Favorite Pasta" is converted into the alternative statements advanced by New World and conveys to consumers that Mueller's is a "national brand" or is the "best selling."

The Court can and should reject these definitions newly minted by New World. The term "America's" is not a representation of being sold everywhere in the United States. Such an assertion is unreasonable on its face. As described above, America can include different entities and geographic boundaries and is, therefore, ambiguous. The term "America's" does not mean "sold throughout the United States," and "sold throughout the United States" does not mean "America's." Likewise, the term "favorite" does not mean "highest selling" and "highest selling" does not mean "favorite." New World cannot substitute a statement not used for that in issue. Consequently, the Court should reject these unwarranted conclusions and dismiss New World's Lanham Act claim.

D. The Court Should Dismiss Or Decline to Exercise Jurisdiction Over the State Law Claims

The Court should dismiss the seventeen state law claims. Common to all of the state law claims is the concept of unfair competition or unfair or deceptive trade practices¹. The court may readily apply the reasoning regarding the Lanham Act claims to these foreign jurisdiction state claims as well. In the alternative, once the claim under the Lanham Act is disposed of, Federal question jurisdiction is absent and the Court may dismiss the remaining claims exercising its own discretion.

¹ See Conn. Gen. Stat. § 42-110b (2002); Del. Code Ann. tit. 6 § 2532 (2002); Fla. Stat. Ann. § 501.204 (West 2002); Ga. Code Ann. § 10-1-372 (2002); 815 Ill. Stat. Chapter § 505/2 (West 2002); La. Rev. Stat. Ann. § 51:1405 (West 2002); Md. Code Ann., Com Law, § 13-301 (2002); Mich. Comp. Laws § 445.903 (2002); N.H. Rev. Stat. Ann. § 358-A:2 N.J. Stat. Ann. § 56:8-2 (West 2002); N.Y. Gen. Bus. Law §§ 349-50 (McKinney 2002); N.C. Gen. Stat. § 75-1.1 (2002); Ohio Rev. Code Ann. § 4165.02 (West 2002); S.C. Code Ann. § 39-5-20 (Law. Co-op. 2002); Tenn. Code Ann. § 47-18-104 (2002); Va. Code Ann. § 59.1-200 (West 2002); Wis. Stat. Ann. § 100.18 (West 2002).

New World alleges jurisdiction under 28 U.S.C. §§ 1338 and 1331 in paragraph 2 of its counterclaim. Section 1331 provides for general federal question jurisdiction. Section 1338(b) reflects a codification of the doctrine of pendent jurisdiction in the context of a trademark claim. *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1571 n.14 (Fed. Cir. 1994).

When the federal question jurisdiction is eliminated, the Court has discretion to dismiss the state law claims. As this Court articulated in *Canada v. Thomas*, 915 F.Supp. 145, 150 (W.D.Mo. 1996), a “district court has broad discretion in determining whether or not to exercise supplemental jurisdiction over state law claims” (citing *Willman v. Heartland Hosp. E.*, 34 F.3d 605, 613 (8th Cir. 1994)). See also *Clark v. City of Kansas City, Mo.*, 99 F.Supp.2d 1064, 1070 (W.D.Mo. 2000) (“a district court can decline to exercise its supplemental jurisdiction if, *inter alia*, it has dismissed all claims over which it has original jurisdiction”).

In the *Canada* case, a former Central Missouri State University football player sued the University and its former football coach under several federal and state theories. *Canada v. Thomas*, 915 F.Supp. at 147. Upon dismissing the federal law claims, this Court explained that because “few resources [had] been expended by both the parties and this Court, [the] Court [would decline] to exercise supplemental jurisdiction” over the state law claims. *Id.* at 150.

Here as in the *Canada* case, few resources have been consumed by the parties and the Court. Discovery has just begun. Accordingly, upon dismissal of the Lanham act claim, it is appropriate to dismiss the state law claims so that they may be resolved, if necessary and sustainable in light of the collateral estoppel effect of this Court’s actions, in their respective state courts.

E. New World Has No Standing to Assert Claims Under the State Laws of Maryland, and New Jersey.

Independent of the above arguments, this Court should dismiss the claims asserted under the laws of Maryland and New Jersey. In Maryland and New Jersey, courts have made it clear

that non-consumer competitors, in the position of New World, have no standing to sue under the asserted statutes. Because New World lacks standing as a matter of law, the Court should dismiss claims eight and eleven.

1. Competitors Have No Standing to Sue Under Maryland Law.

In its eighth claim, New World alleges that the use of the slogan “America's Favorite Pasta” violates Maryland Code, Commercial Law, § 13-301. However, competitors have no standing to sue under the Maryland Consumer Protection Act (“the Maryland CPA”), codified at Maryland Code, Commercial Law § 13-301 et seq. *See Penn-Plax, Inc. v. L. Schultz, Inc.*, 988 F.Supp. 906, 909 (D.Md. 1997). In *Penn-Plax*, the federal district court pointed out that many states have enacted consumer protection laws, and while some courts have allowed businesses to pursue consumer fraud charges, many others have not allowed the scope of the acts to be expanded in that way. *Id.* The Court concluded that Maryland does not provide for competitor standing. *Accord Fare Deals, Ltd. v. World Choice Travel.com, Inc.*, 180 F.Supp.2d 678, 692 (D. Md. 2001) (characterizing the *Penn-Plax* decision as having canvassed Maryland cases in concluding that Maryland law does not permit competitor standing under the Maryland CPA). The Maryland CPA is available only to consumers involved in transactions for consumer goods. *Boatel Indus. v. Hester*, 550 A.2d 389, 399 (Md. App. 1998).

It is undisputed that New World is AIPC's competitor. Therefore no relief can be granted, and this claim should be dismissed.

2. Only Bona Fide Consumers Have Standing to Sue Under the New Jersey Statute.

In its eleventh claim, New World alleges that the use of the slogan “America's Favorite Pasta” violates New Jersey Statute 56:8-2 (“the New Jersey Act”). Only *bona fide* consumers are entitled to relief under the New Jersey Act. *See Grauer v. Norman Chevrolet Geo*,

729 A.2d 522, 524 (N.J. Super. Ct. App. Div. 1998). New World has not alleged that it is a *bona fide* consumer of Mueller's pasta. However, in deciding a motion under Fed.R.Civ. Pro. 12(b)(6) facts and inferences are to be construed in the light most favorable to the nonmoving party, unless they are unreasonable.

In other New Jersey cases, the court has held that businesses can avail themselves of the protection of the New Jersey Act, but only when they are acting in the capacity of a consumer. *See, e.g. Hundred East Credit Corp v. Eric Schuster Corp.*, 515 A.2d 246 (N.J. Super. Ct. App. Div. 1986) (where plaintiff was a business purchaser of computer equipment) and *Coastal Group, Inc. v. Dryvit Systems, Inc.*, 643 A.2d 649 (N.J. Super. Ct. App. Div. 1994) (where counterclaimant was a business consumer of a well system equipment supplier).

Accordingly, the question is whether it would be an unreasonable inference to consider New World a *bona fide* consumer of Mueller's pasta. The Court may consider facts pleaded by the nonmoving party that tend to undermine its legal theory. New World asserts that it is the "number one" selling pasta manufacturer in the United States. The "number one" selling pasta manufacturer in the United States can reasonably be expected to have sufficient pasta to use for its own consumption. Therefore, based on the New World's own allegations, it is unreasonable to believe that New World could be a *bona fide* consumer of Mueller's pasta. Under New Jersey law, the New Jersey claim should be dismissed.

IV. CONCLUSION

New World's allegations, even if taken as true, do not demonstrate any cognizable theory under the Lanham Act based on AIPC's use of the slogan "America's Favorite Pasta" in connection with its Mueller's brand products. For the foregoing reasons, the Court is urged to dismiss New World's counterclaim under Fed. R. Civ. P 12(b)(6) for failure to state a claim upon

which relief may be granted. Further, for the above-stated reasons, AIPC respectfully requests the Court to decline to exercise jurisdiction over the state law claims and at a minimum, dismiss claims eight and eleven for lack of standing.

Respectfully submitted,

AMERICAN ITALIAN PASTA COMPANY

Date: September 27, 2002

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that I electronically filed Plaintiff's MEMORANDUM IN SUPPORT OF AMERICAN ITALIAN PASTA COMPANY'S MOTION TO DISMISS DEFENDANT NEW WORLD PASTA COMPANY'S COUNTERCLAIMS UNDER FED. R. CIV. PRO. 12(b)(6) with the Clerk of the Court for the Western District of Missouri using the CM/ECF system which sent notification of such filing to Brent Coverdale (bcoverdale@shb.com) of Shook, Hardy & Bacon L.L.P., One Kansas City Place, 1200 Main Street, Kansas City, MO 64105-2118; Forrest A. Hainline III (aikidolaw@aol.com), Suite 440, 5335 Wisconsin Avenue, N.W., Washington, D.C. 20015 and I hereby certify that I have e-mailed the document to the following non CM/ECF participants:

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EXHIBIT L

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
WESTERN DIVISION

AMERICAN ITALIAN PASTA COMPANY)
)
Plaintiff,)
)
v.) No. 02-0594-CV-W-SOW
)
NEW WORLD PASTA COMPANY)
)
Defendant.)

ORDER

Before the Court are defendant New World Pasta Company's Motion for Partial Summary Judgment (Doc. #26), plaintiff American Italian Pasta Company's Suggestions in Opposition, and defendant's Reply. For the reasons stated herein, defendant's motion is denied.

I. Background

Plaintiff American Italian Pasta Company ("AIPC") filed a Complaint for Declaratory Judgment on June 18, 2002. Plaintiff's Complaint seeks a declaratory judgment pursuant to 28 U.S.C. §2201(a) that its use of the phrase "America's Favorite Pasta" on its pasta packaging and in advertising and promoting its pasta products does not constitute false advertising in violation of 15 U.S.C. §1125(a)(1)(B).

Defendant New World Pasta Company ("New World") responded to plaintiff's Complaint by filing an Answer and Counterclaim on August 2, 2002. In the Answer and Counterclaim, New World alleges that AIPC's use of the advertising claim "America's Favorite Pasta" on its Mueller's branded dried pastas is literally false because it conveys to consumers that Mueller's is a national brand of pasta and is the number one selling brand of pasta in the country. New World alleges that Mueller's branded pasta is not sold anywhere west of the Mississippi River and is, at

**ECF
DOCUMENT**

I hereby attest and certify this is a printed copy of a document which was electronically filed with the United States District Court for the Western District of Missouri.

Date Filed: 2-25-03

P.L. BRUNE, CLERK

By: Wilfredo Crespo, Deputy Clerk

best, in second place in sales. New World asserts that AIPC's advertising claim "America's Favorite Pasta" on its Mueller's branded pasta is a false representation in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a) and in violation of the unfair competition laws of seventeen states in which Mueller's pasta is sold. New World seeks injunctive relief and damages.

New World has filed a motion for partial summary judgment. The following undisputed material facts are relevant to the pending motion: AIPC has been manufacturing Mueller's dried pasta since 1997. From 1997 through November of 2000, AIPC manufactured Mueller's dried pasta for Best Foods. Then, on or about November 14, 2000, AIPC purchased the exclusive rights to own all aspects of the Mueller's pasta business. At that time, AIPC assumed responsibility for packaging, distribution, pricing, and marketing of the Mueller's brand pastas.

The phrase "America's Favorite Pasta" has appeared continuously on Mueller's pasta packaging since at least November of 2000.¹ These packages are placed on product shelves next to competitive brands of pasta at the point of purchase. The phrase "America's Favorite Pasta" has also been used in advertising materials for Mueller's brand pasta products.

The parties agree that Barilla was the largest seller of dried pasta in the United States during the year 2002. Similarly, it is undisputed that in its 2001 Annual Report, AIPC did not claim that Mueller's is the largest selling brand of dried pasta in the United States. In addition, it is undisputed that Mueller's brand pasta is not sold anywhere west of the Mississippi River. The advertising and packages for AIPC's Mueller's brand of dried pasta products have not claimed

¹There is a dispute between the parties as to whether or not the phrase "America's Favorite Pasta" was used on packages of Mueller's brand pasta between 1997 and 2000 while AIPC was manufacturing the pasta for Best Foods.

that Mueller's is the best-selling pasta in the United States. Mueller's claims a brand heritage starting in 1867 and it has been continuously sold through the present.

On May 21, 2002, defendant New World sent a letter to plaintiff AIPC demanding that AIPC assure New World in writing no later than May 29, 2002 that by July 2, 2002, AIPC would cease all use of the phrase "America's Favorite Pasta" for Mueller's products. On June 20, 2002, AIPC filed this lawsuit seeking a declaratory judgment that its use of the phrase "America's Favorite Pasta" does not violate § 43(a) of the Lanham Act.

In addition to these undisputed material facts, defendant New World contends that a substantial number of consumers perceive AIPC's phrase "America's Favorite Pasta" as conveying that Mueller's is the number one selling pasta in the country. New World also asserts that a substantial number of consumers perceive the phrase as conveying that Mueller's is a national brand of pasta available everywhere in the country. New World's allegations are based on the results of a consumer survey. Plaintiff AIPC disputes New World's allegations, claiming that these conclusions are unreliable due to the flawed methodology and analysis found in the protocol of the study relied upon by New World.

II. Standard

A motion for summary judgment should be granted if, viewing the evidence in the light most favorable to the non-moving party, there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); Rafos v. Outboard Marine Corp., 1 F.3d 707, 708 (8th Cir. 1993) (citing Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986)). A defendant who moves for summary judgment has the burden of showing that there is no genuine issue of fact for trial. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256 (1986). A plaintiff opposing a properly supported motion for summary judgment may not rest upon the

allegations contained in the pleadings, “but must set forth specific facts showing there is a genuine issue for trial.” Id.

III. Discussion

Defendant New World alleges that plaintiff AIPC’s use of the phrase “America’s Favorite Pasta” on its Mueller’s brand pasta packaging and in advertising materials for its Mueller’s brand pasta is literally false and violates the Lanham Act. In the alternative, New World argues that AIPC’s use of the phrase is impliedly false and misleading. AIPC contends that the phrase is non-actionable puffery.

A. Literal Falsity

To demonstrate falsity within the meaning of the Lanham Act, a plaintiff may show (1) that the statement is literally false as a factual matter or (2) that the statement is literally true or ambiguous but it implicitly conveys a false impression, is misleading in context, or is likely to deceive consumers. United Industries Corp. v. The Clorox Co., 140 F.3d 1175, 1180 (8th Cir. 1998) (citations omitted). Defendant New World alleges that AIPC’s use of the phrase “America’s Favorite Pasta” on its Mueller’s brand pastas and in advertising those pastas is literally false. Courts determine whether an accused statement is literally false without considering factual issues about public perception of the statement. Id. “In assessing whether an advertisement is literally false, a court must analyze the message conveyed within its full context.” Id. at 1181 (citation omitted).

Defendant New World argues that within the advertising industry, claims to be America’s “favorite” are well known and “only the market leader can properly make the claim.” New World suggests that because AIPC’s Mueller’s brand is not the best-selling brand of pasta in the United States, AIPC’s use of the phrase “America’s Favorite Pasta” is literally false. This Court

disagrees.

As defendant New World concedes, there are no court decisions addressing an advertising claim of being a “favorite.” Instead, New World relies on decisions issued by the National Advertising Division of the Better Business Bureau (“NAD”). These decisions are not binding on this Court nor are they persuasive. The facts and holdings found in the NAD decisions do not support defendant’s conclusions.

The use of the term “favorite” is not literally false. The term “favorite” is ambiguous and does not necessarily refer to the best selling item in a category. It is logical that a product could be a favorite without being the best-selling product in its category. For example, a group of individual consumers could participate in a wine tasting study. Their favorite wine might be a red wine that sells for \$200 a bottle. That wine would be their favorite, but it probably would not become the best-selling red wine due to its cost.

Furthermore, as plaintiff AIPC suggests, the term “favorite” is ambiguous. It could refer to a preference in quality, taste, price, or cooking ease. Defendant has not established that the words in the phrase “America’s Favorite Pasta” have a specific meaning and that the phrase is unambiguously, literally false.

Therefore, the Court finds that as a factual matter, plaintiff’s use of the phrase “America’s Favorite Pasta” is not literally false. Defendant’s motion for summary judgment is denied as to its claim of literal falsity.

2. False Impression, Misleading, or Deceptive

Defendant New World argues that even if the statement is too ambiguous to be literally false, it violates the Lanham Act because it “conveys a false message to consumers.” Defendant

relies on a consumer study that it claims demonstrates that a substantial number of consumers (over 40%) perceive the advertising claim "America's Favorite Pasta" to convey that plaintiff's Mueller's brand pasta is the best selling brand of dried pasta.

In order to establish that plaintiff AIPC is violating the Lanham Act, defendant New World must show:

1. a false statement of fact was made by the defendant in a commercial advertisement about its own or another product;
2. the statement actually deceived or has the tendency to deceive a substantial segment of its audience;
3. the deception is material, in that it is likely to influence the purchasing decision;
4. the defendant caused its false statement to enter interstate commerce; and
5. the plaintiff has been or is likely to be injured as a result of the false statement, either by direct diversion of sales from itself to defendant or by a loss of goodwill associated with its products.

United Indus. Corp. v. Clorox Co., 140 F.3d at 1180. A determination of implicit falsity requires either proof of wilfulness or actual material misleading of consumers. Id. at 1183.

Plaintiff AIPC argues that its use of the phrase "America's Favorite Pasta" is non-actionable "puffery." "A court may consider as a matter of law whether the alleged misrepresentation in an advertisement is a statement of fact, actionable under the Lanham Act, or mere puffery." In re Century 21-RE/MAX Real Estate Adver. Claims Litig., 882 F.Supp. 915, 926 (C.D. Cal. 1994)(citing Cook, Perkiss, & Leihe, Inc. v. N. Cal. Collection Serv., 911 F.2d 242, 245 (9th Cir. 1990)).

"Puffery is exaggerated advertising, blustering, and boasting upon which no reasonable

buyer would rely and is not actionable under § 43(a).” United Indus. Corp., 140 F.3d at 1180 (internal quotations omitted). Due to their generalized nature, advertisements or statements that fall into the category of “puffery” do not meet the first and second elements required under § 43(a) because “it is beyond the realm of reason to assert . . . that a reasonable consumer would interpret [the puffery] as a factual claim upon which he or she could rely.” In re Century 21, 882 F.Supp. at 926 (citation omitted). Puffing applies to claims that cannot be proven false because they are not capable of measurement. United Indus. Corp., 140 F.3d at 1180; Castrol Inc. v. Pennzoil Co., 987 F.2d 939, 946 (3rd Cir. 1993).

Viewed in context, the phrase “America’s Favorite Pasta” is the kind of general claim of superiority that is “so vague, it would be understood as a mere expression of opinion.” Pizza Hut, Inc. v. Papa John’s Int’l Inc., 227 F.3d 489, 496 (5th Cir. 2000), cert. denied, 532 U.S. 920 (2001)(citing 4 J. Thomas McCarthy, McCarthy of Trademarks and Unfair Competition, § 27.38 (4th ed. 1996)).

Drawing guidance from the writings of our sister circuits and the leading commentators, we think that non-actionable “puffery” comes in at least two possible forms: (1) an exaggerated, blustering, and boasting statement upon which no reasonable buyer would be justified in relying; or (2) a general claim of superiority over comparable products that is so vague that it can be understood as nothing more than a mere expression of opinion.

Pizza Hut, Inc., 277 F.3d at 496-97.

The term “favorite” necessarily implies an opinion. Plaintiff AIPC has not specified that its Mueller’s brand pasta is a favorite based upon any criteria for evaluating pasta. *See In Re Century 21*, 882 F.Supp. at 928 (“the chairman of RMI has ‘declared RE/MAX #1 in the United States - and the World.’ Not only is this mere opinion, but it makes no reference to the category in which RE/MAX is number one.”). As recognized in Pizza Hut, Inc., “Bald assertions of superiority or general statements of opinion cannot form the basis of Lanham Act liability.” 227

F.3d at 496 (citations omitted). To be actionable, the statements at issue “must be a ‘specific and measurable claim, capable of being proved false or of being reasonably interpreted as a statement of objective fact.’” *Id.* (citing Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co., 173 F.3d 725, 731 (9th Cir. 1999)).

Defendant has not persuaded the Court that the phrase “America’s Favorite Pasta” is a specific and measurable claim. Rather, the phrase is a “general claim of superiority over comparable products that is so vague that it can be understood as nothing more than a mere expression of opinion.” Pizza Hut, Inc., 227 F.3d at 497.

Therefore, this Court finds as a matter of law that the phrase “America’s Favorite Pasta” is mere puffery and is not actionable under the Lanham Act.

IV. Conclusion

For the reasons stated above, it is hereby

ORDERED that defendant New World Pasta Company’s Motion for Partial Summary Judgment (Doc. #26) is denied. It is further

ORDERED that defendant’s Counterclaim is dismissed based upon the Court’s finding that the phrase “America’s Favorite Pasta” constitutes non-actionable “puffery” and is not a violation of the Lanham Act. It is further

ORDERED that defendant’s state law claims are dismissed as the Court declines to exercise supplemental jurisdiction over such claims having dismissed defendant’s federal claim.

/s/Scott O. Wright
SCOTT O. WRIGHT
Senior United States District Judge

Dated: 2-25-03

EXHIBIT M

Ashcroft, 355 F.3d 1075, 1085 (7th Cir. 2004). Indeed, we frequently have acknowledged that it is unreasonable to expect asylum applicants to procure corroborating documents when official records are "in disarray," either because of war, revolution or simply lack of institutional regularity. *Kourski v. Ashcroft*, 355 F.3d 1038, 1039 (7th Cir.2004). We trust that IJs will not continue to insist on corroborating evidence when common sense and institutional experience suggest that there is none to be had. Additionally, we remind those evaluating administrative records that adverse credibility determinations should not be grounded in trivial details or easily explained discrepancies; as recounted above, an adverse credibility determination must be supported by "specific, cogent reasons" that "bear a legitimate nexus to the finding." *Ahmad*, 163 F.3d at 461.¹⁰

Conclusion

For the foregoing reasons, the petition for review is denied, and the judgment of the BIA is affirmed.

PETITION FOR REVIEW DENIED; AFFIRMED.



10. We note that, even if we had disagreed with the BIA's credibility determination, we would be hesitant to remand this case to the BIA. It is clear from the administrative record that, at the time of Ms. Korniejew's asylum hearing, the government of Poland did not condone religious discrimination and, indeed, that "[c]urrent law place[d] Protestant, Catholic, Orthodox, and Jewish communities on the same legal footing." A.R. 86. The 1997 Country Report also noted that although "[a]nti-Semitic feelings persist among certain sectors of the population, occasionally manifesting themselves in acts of vandalism and physical or verbal abuse," "surveys in recent years show a continuing decline in anti-Semitic sentiment, and avowedly anti-Semitic candidates fare very poorly in elections." *Id.* In short, between the time that Ms. Korniejew

AMERICAN ITALIAN PASTA COMPANY, Appellee,

v.

NEW WORLD PASTA COMPANY, Appellant.

No. 03-2065.

United States Court of Appeals,
Eighth Circuit.

Submitted: Nov. 17, 2003.

Filed: June 7, 2004.

Background: Pasta manufacturer sued competitor, alleging that use of phrase "America's Favorite Pasta" was false or misleading advertising under Lanham Act. The United States District Court for the Western District of Missouri, Scott O. Wright, J., entered summary judgment for competitor, and claimant appealed.

Holdings: The Court of Appeals, Riley, Circuit Judge, held that:

- (1) phrase was not actionable, standing alone;
- (2) phrase was not actionable, in context of competitor's packaging; and

left Poland in 1989 and the time of her hearing in 1998, the circumstances for Jews in Poland had improved markedly. Furthermore, the most recent International Religious Freedom Report establishes that circumstances continue to improve; it notes that "[t]he Constitution provides for freedom of religion, and the Government generally respects this right in practice." See U.S.D.O.S. International Religious Freedom Report (Poland) at 1. When State Department documents establish changed country conditions, we have stated that a remand is not required. See *Dobrota v. INS*, 195 F.3d 970, 974 (7th Cir.1999) (stating that "remand would be futile in light of most current conditions in Romania as reflected in the most recent State Department report").

- (3) unverifiable and nonactionable statement was not rendered verifiable and actionable as result of consumer survey.

Affirmed.

1. Trade Regulation \S 870(1)

To establish false or deceptively misleading advertising claim, under Lanham Act, plaintiff must show (1) false statement of fact by alleged violator, on alleged violator's packaging, about its own or another's product, (2) statement actually deceived or had tendency to deceive substantial segment of its audience, (3) deception was material, in that it was likely to influence purchasing decision, (4) defendant caused its false statement to enter interstate commerce, and (5) plaintiff has been or is likely to be injured as result of false statement. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

2. Trade Regulation \S 870(1)

Statements can constitute deceptive advertising, under Lanham Act, if they raise literally false factual commercial claims, or literally true or ambiguous factual claims which implicitly convey false impression, are misleading in context, or are likely to deceive consumers. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

3. Trade Regulation \S 870(1)

"Puffery," nonactionable as false advertising under Lanham Act, consists of exaggerated statements of bluster or boast upon which no reasonable consumer would rely, or vague or highly subjective claims of product superiority, including bald assertions of superiority. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

See publication Words and Phrases for other judicial constructions and definitions.

4. Trade Regulation \S 870(1)

"Factual claim," which may constitute actionable false advertising under Lanham Act, is statement that admits of being adjudged true or false in way that admits of empirical verification. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

See publication Words and Phrases for other judicial constructions and definitions.

5. Trade Regulation \S 870(1)

Puffery, which is not actionable as false advertising under Lanham Act, and statements of fact, which are actionable, are mutually exclusive. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

6. Trade Regulation \S 870(1)

Phrase "America's Favorite Pasta," standing alone, was not statement of fact actionable as false advertising under Lanham Act; phrase was not specific measurable claim and could not be reasonably interpreted as objective fact. Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

7. Trade Regulation \S 870(1)

Phrase "America's Favorite Pasta," did not constitute false advertising in violation of Lanham Act, when viewed in context of its use on pasta packaging, when it appeared on packaging in conjunction with true factual statements that product was 130 years old and made from 100% semolina, and unverifiable and non actionable statements, such as declaration that product "tastes good." Lanham Trade-Mark Act, \S 43(a), 15 U.S.C.A. \S 1125(a).

8. Trade Regulation \S 870(1)

Unverifiable and nonactionable statement, that product was "America's Favorite Pasta," was not rendered verifiable and amenable to false advertising suit under Lanham Act, as result of consumer survey in which 33% of buyers perceived state-

ment as declaration that advertised brand was number one nationally, and that 50% believed brand was national in reach. Lanham Trade-Mark Act, § 43(a), 15 U.S.C.A. § 1125(a).

Forrest A. Hainline, III, argued, San Francisco, CA (Brent N. Coverdale, on the brief), for appellant.

William R. Hansen, argued, New York, NY (Thomas H. Van Hoozer, on the brief), for appellee.

Before RILEY, RICHARD S.
ARNOLD, and MELLOY, Circuit Judges.

RILEY, Circuit Judge.

"America's Favorite Pasta"-Commercial puffery or factual claim?

American Italian Pasta Company (American) sued New World Pasta Company (New World), seeking a declaratory judgment that American's use of the phrase "America's Favorite Pasta" does not constitute false or misleading advertising under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B) (2000). New World counterclaimed, asserting American's use of "America's Favorite Pasta" violated the Lanham Act and many states' unfair competition laws. On summary judgment, the district court¹ concluded American's use of "America's Favorite Pasta" did not violate the Lanham Act, dismissing New World's counterclaims and

declining to exercise jurisdiction over New World's state law claims. We affirm.

I. BACKGROUND

From 1997 to 2000, American² manufactured Mueller's brand (Mueller's) dried pasta for Best Foods. In the fall of 2000, American purchased Mueller's and assumed all packaging, distributing, pricing, and marketing for the brand. Since purchasing Mueller's, American has placed the phrase "America's Favorite Pasta" on Mueller's packaging. On various packages, the phrases "Quality Since 1867," "Made from 100% Semolina," or "Made with Semolina" accompany the phrase "America's Favorite Pasta." The packaging also contains a paragraph in which the phrase "America's Favorite Pasta" appears. The paragraph states (1) pasta lovers have enjoyed Mueller's pasta for 130 years; (2) claims Mueller's "pasta cooks to perfect tenderness every time," because Mueller's uses "100% pure semolina milled from the highest quality durum wheat," and (3) encourages consumers to "[t]aste why Mueller's is America's favorite pasta."

New World³ sent American a letter demanding American cease and desist using the phrase "America's Favorite Pasta." Consequently, American filed this suit, requesting a declaration that its use of the phrase "America's Favorite Pasta" does not constitute false or misleading advertising under the Lanham Act. In its federal counterclaim, New World asserted American's use of "America's Favorite Pasta" violated the Lanham Act. New World claims American's use of the phrase is

1. The Honorable Scott O. Wright, United States District Judge for the Western District of Missouri.

2. American sells dried pasta under the brand names Mueller's, Golden Grain, Mrs. Grass, Ronco, Luxury, R & F, Global Al, Pennsylvania Dutch, and Anthony's.

3. New World sells dried pasta under the brand names Ronzoni, San Giorgio, Skinner, American Beauty, Light n' Fluffy, Goodman, Mrs. Weiss, Prince, Creamette, Monder, Albaro, Catelli, Lancia, and Ronzoni Canada.

false or misleading advertising, because, according to New World's consumer survey, the phrase conveys Mueller's is a national pasta brand or the nation's number one selling pasta. American and New World agree Barilla sells the most dried pasta in the United States and American's brands are regional.

American moved to dismiss New World's counterclaims, arguing the phrase "America's Favorite Pasta" constituted non-actionable puffery. New World resisted American's motion and filed a motion for partial summary judgment. The district court denied American's motion, concluding it would have to consider facts outside the pleadings to determine if the phrase "America's Favorite Pasta" constituted puffery. Two weeks later, the district court denied New World's motion for partial summary judgment, dismissed New World's Lanham Act counterclaim, and declined to exercise jurisdiction over New World's state law counterclaims. The district court concluded the phrase "America's Favorite Pasta" constitutes non-actionable puffery as a matter of law, and the phrase is not actionable under the Lanham Act. New World appeals, contending the phrase "America's Favorite Pasta" is not puffery, but is a deceptive factual claim.

II. DISCUSSION

[I] We review the district court's summary judgment decision de novo. *Interstate Cleaning Corp. v. Commercial Underwriters Ins. Co.*, 325 F.3d 1024, 1027

4. Section 43(a) of the Lanham Act states, in pertinent part:

(1) Any person who, on or in connection with any goods ... uses in commerce any ... false or misleading description of *fact*, or false or misleading representation of *fact*, which—

...

(8th Cir.2003). A purpose of the Lanham Act is "to protect persons engaged in commerce against false advertising and unfair competition." *United Indus. Corp. v. Clorox Co.*, 140 F.3d 1175, 1179 (8th Cir.1998). To establish a false or deceptively misleading advertising claim under section 43(a) of the Lanham Act,⁴ New World must establish:

(1) a false statement of *fact* by [American on its packaging] about its own or another's product; (2) the statement actually deceived or has the tendency to deceive a substantial segment of its audience; (3) the deception is material, in that it is likely to influence the purchasing decision; (4) the defendant caused its false statement to enter interstate commerce; and (5) the plaintiff has been or is likely to be injured as a result of the false statement.

Id. at 1180 (emphasis added). The failure to establish any element of the prima facie case is fatal. *Pizza Hut, Inc. v. Papa John's Int'l, Inc.*, 227 F.3d 489, 495 (5th Cir.2000).

[2, 3] Under section 43(a), two categories of actionable statements exist: (1) literally false factual commercial claims; and (2) literally true or ambiguous factual claims "which implicitly convey a false impression, are misleading in context, or [are] likely to deceive consumers." *United Indus.*, 140 F.3d at 1180. Besides actionable statements, a category of non-actionable statements exists. *Id.* Many statements fall into this category, popularly known as puffery. *Id.* Puffery exists in

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a) (emphasis added).

two general forms: (1) exaggerated statements of bluster or boast upon which no reasonable consumer would rely; and (2) vague or highly subjective claims of product superiority, including bald assertions of superiority. *Pizza Hut*, 227 F.3d at 496–97; *United Indus.*, 140 F.3d at 1180.

[4] Juxtaposed to puffery is a factual claim. A factual claim is a statement that “(1) admits of being adjudged true or false in a way that (2) admits of empirical verification.” *Pizza Hut*, 227 F.3d at 496 (quoting *Presidio Enters., Inc. v. Warner Bros. Distrib. Corp.*, 784 F.2d 674, 679 (5th Cir. 1986)). To be actionable, the statement must be a “specific and measurable claim, capable of being proved false or of being reasonably interpreted as a statement of objective fact.” *Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co.*, 173 F.3d 725, 731 (9th Cir.1999); cf. *United Indus.*, 140 F.3d at 1180 (noting puffery does not include “false descriptions of specific or absolute characteristics of a product and specific, measurable claims of product superiority”). Generally, opinions are not actionable. *Coastal Abstract*, 173 F.3d at 731.

[5] Puffery and statements of fact are mutually exclusive. If a statement is a specific, measurable claim or can be reasonably interpreted as being a factual claim, i.e., one capable of verification, the statement is one of fact. Conversely, if the statement is not specific and measurable, and cannot be reasonably interpreted as providing a benchmark by which the veracity of the statement can be ascertained, the statement constitutes puffery. Defining puffery broadly provides advertisers and manufacturers considerable lee-

way to craft their statements, allowing the free market to hold advertisers and manufacturers accountable for their statements, ensuring vigorous competition, and protecting legitimate commercial speech.

A. “America’s Favorite Pasta” Standing Alone

[6] The phrase “America’s Favorite Pasta,” standing alone, is not a statement of fact as a matter of law. The key term in the phrase “America’s Favorite Pasta” is “favorite.” Used in this context, “favorite” is defined as “markedly popular especially over an extended period of time.” Webster’s Third New International Dictionary 830 (unabridged 1961). Webster’s definition of “favorite” begs the question of how “popular” is defined. In this context, “popular” is defined as “well liked or admired by a particular group or circle.” *Id.* at 1766. By combining the term “favorite” with “America’s,” American claims Mueller’s pasta has been well liked or admired over time by America, a non-definitive person.⁵

“America’s Favorite Pasta” is not a specific, measurable claim and cannot be reasonably interpreted as an objective fact. “Well liked” and “admired” are entirely subjective and vague. Neither the words “well liked” nor “admired” provide an empirical benchmark by which the claim can be measured. “Well liked” and “admired” do not convey a quantifiable threshold in sheer number, percentage, or place in a series. A product may be well liked or admired, but the product may not dominate in sales or market share. For example, assume a consumer’s favorite cut of meat is beef tenderloin. If we were to

5. We note the outcome of this case might be different if American claimed Mueller’s pasta was the favorite pasta of a specific person or an identifiable group. Such a claim might be a statement of fact. For example, the claim

that Mueller’s is Judge Michael Melloy’s favorite pasta would not be puffery. Such a statement is a factual statement that could be verified by simply asking Judge Melloy which pasta brand is his favorite.

look at the sheer amount of beef tenderloin our hypothetical consumer buys relative to other cuts of meat, beef tenderloin may not have a sizable market share or account for a significant percentage of the amount of money spent on meat. Therefore, we could not accurately determine whether beef tenderloin was the consumer's favorite cut of beef based on those benchmarks. The fact is, the consumer may admire beef tenderloin and like it best among beef cuts, but beef tenderloin is too expensive for our consumer to eat often. Likewise, sales volume and total dollars spent on particular pasta brands in the United States may not uncover America's favorite pasta.

"America's Favorite Pasta" also does not imply Mueller's is a national brand. First, "America's" is vague, and "America's," as well as "America" and "American" used in a similar context, is a broad, general reference. Second, a brand, chain, or product could be America's favorite without being national. For example, an individual restaurant or restaurant chain may be America's favorite, but may be located only in one or a few states. Although the restaurant chain may not be available nationally, consumers may prefer the restaurant because of its quality of food, quality of service, atmosphere, or some other attribute. Because "America's Favorite" depends on numerous characteristics, many of which may be intrinsic, a product (be it a restaurant, grits, or pasta) need not be sold nationally to be America's favorite.

B. "America's Favorite Pasta" Viewed In Context

[7] Having decided the phrase "America's Favorite Pasta," standing alone, is not a statement of fact, we consider whether the context in which the phrase is used by American transforms it into a statement of fact. See *Pizza Hut*, 227 F.3d at 495 n. 5 (noting the context in which a statement

appears can be used to determine if the statement is actionable under the Lanham Act). "America's Favorite Pasta" appears on Mueller's packaging in two places. First, Mueller's packaging contains the phrase "America's Favorite Pasta" in the following paragraph (Paragraph):

For over 130 years, pasta lovers have enjoyed the great taste of Mueller's. Our pasta cooks to perfect tenderness every time because it's made from 100% pure semolina milled from the highest quality durum wheat. Taste why Mueller's is America's favorite pasta.

Second, "America's Favorite Pasta" appears directly above "Quality Since 1867" on some packaging, and directly above "Made from 100% Semolina" or "Made with Semolina" on other packaging (Phrases).

The Paragraph and the Phrases fail to transform "America's Favorite Pasta" into a statement of fact. The Paragraph does not suggest a benchmark by which the veracity of American's statement can be verified. The Paragraph generally declares the brand has existed for 130 years, Mueller's tastes great, cooks to perfect tenderness, and is manufactured from high quality grain. We assume, *arguendo*, the sentence "Taste why Mueller's is America's favorite pasta" incorporates the attributes listed in the Paragraph into American's claim. Two attributes listed in the Paragraph are subject to verification: Mueller's is made from 100% pure semolina, and the brand is more than 130 years old. New World does not contend these claims are false. The remaining attributes listed in the Paragraph are unquantifiable and subject to an individual's fancy.

Notwithstanding the incorporation of these claims into "America's Favorite Pasta," the unverifiable attributes attenuate verifiable, and accurate, claims. "Taste why Mueller's is America's favorite pasta"

suggests all of the attributes listed in the Paragraph are the reason Mueller's is "America's Favorite Pasta" and suggests each carries equal weight. The unquantifiable attributes coupled with two verifiable attributes do not render the phrase "America's Favorite Pasta" subject to verification.

Similarly, the Phrases do not convey a benchmark for "America's Favorite Pasta." The term "quality" is vague, entirely subjective, and a bare assertion of product superiority. In the context used, "quality" means "inherent or intrinsic excellence of character or type" or "superiority in kind." Webster's Third New International Dictionary 1858 (unabridged 1961). The only portion of "Quality Since 1867" that can be verified is "Since 1867," but "Since 1867" does not provide a methodology or a reason why Mueller's is America's favorite. The words simply state, accurately, when the brand was founded. Likewise, while presenting factual claims, the phrases "Made from 100% Semolina" and "Made with Semolina" do not define a methodology by which to ascertain the veracity of American's claim that Mueller's is "America's Favorite Pasta." The two phrases simply, and correctly, list characteristics of the pasta.

C. Consumer Surveys

[8] We now consider whether the results of New World's consumer survey transform the phrase "America's Favorite Pasta" into a specific, measurable claim. In its survey, New World asked consumers if the phrase "America's Favorite Pasta" conveyed a meaning. According to New World, thirty-three percent of those surveyed allegedly perceived the phrase "America's Favorite Pasta" to mean Mueller's is the number one brand. Fifty percent of those surveyed allegedly perceived

the phrase "America's Favorite Pasta" to mean Mueller's is a national brand.

The Seventh Circuit confronted a similar question in *Mead Johnson & Co. v. Abbott Laboratories*, 201 F.3d 883 (7th Cir.), *opinion amended on denial of reh'g*, 209 F.3d 1032 (7th Cir.2000). Having concluded the phrase "1st Choice of Doctors" conveyed more doctors prefer this product over its rivals, the Seventh Circuit considered whether a consumer survey can assign a different meaning to a phrase. *Id.* at 883-84. Mead Johnson's survey indicated consumers perceived the phrase "1st Choice of Doctors" to mean a majority of doctors. Concluding the district court erred in using the survey to assign such a meaning, the Seventh Circuit noted, "never before has survey research been used to determine the meaning of words, or to set the standard to which objectively verifiable claims must be held." *Id.* at 886. While acknowledging dictionaries are surveys by people who devote their entire lives to discovering the usage of words, the Seventh Circuit cogitated "[i]t would be a bad idea to replace the work of these professionals with the first impressions of people on the street." *Id.* The Seventh Circuit reasoned that using consumer surveys to determine the benchmark by which a claim is measured would remove otherwise useful words from products and would reduce ads and packaging to puffery. *Id.* at 886-87.

We agree with the Seventh Circuit. To allow a consumer survey to determine a claim's benchmark would subject any advertisement or promotional statement to numerous variables, often unpredictable, and would introduce even more uncertainty into the market place. A manufacturer or advertiser who expended significant resources to substantiate a statement or forge a puffing statement could be blindsided by a consumer survey that defines

the advertising statement differently, subjecting the advertiser or manufacturer to unintended liability for a wholly unanticipated claim the advertisement's plain language would not support. The resulting unpredictability could chill commercial speech, eliminating useful claims from packaging and advertisements. As the Seventh Circuit noted, the Lanham Act protects against misleading and false statements of fact, not misunderstood statements. *Id.* at 886.

III. CONCLUSION

For the foregoing reasons, we affirm.



Roger KOEHN, Appellant,

v.

INDIAN HILLS COMMUNITY COLLEGE; James Lindenmayer, Appellees.

No. 03-3163.

United States Court of Appeals,
Eighth Circuit.

Submitted: April 15, 2004.

Filed: June 9, 2004.

Background: Public employee, a night shift custodian at community college, filed § 1983 action against employer and its vice president of personnel and administration, alleging wrongful discharge in violation of First Amendment and state public policy. The United States District Court for the Southern District of Iowa, Ronald E. Longstaff, Chief Judge, 2003 WL 21976025, granted summary judgment in favor of defendants. Employee appealed.

Holdings: The Court of Appeals, McMillan, Circuit Judge, held that:

- (1) employee did not engage in constitutionally protected speech when he engaged in conversation with coworker during break regarding various employees' salaries, which had been published in list in newspaper he had brought to work, and
- (2) employee's termination did not violate clearly defined public policy of state of Iowa.

Affirmed.

1. Federal Courts ⇌776

Court of Appeals reviews grant of summary judgment de novo. Fed.Rules Civ.Proc.Rule 56, 28 U.S.C.A.

2. Colleges and Universities ⇌8.1(3)

Constitutional Law ⇌90.1(7.3)

Custodian at Iowa community college was not engaging in constitutionally protected speech when he engaged in conversation with coworkers during break regarding various employees' salaries, which had been published in newspaper he had brought to work; custodian was speaking solely as employee, not as concerned taxpayer, as he did not question salaries as misuse of public funds, call for reforms in method of determining salaries, or otherwise voice any criticisms or concerns about published salaries. U.S.C.A. Const. Amend. 1.

3. Labor and Employment ⇌759

Under Iowa law, at-will employee may recover on claim for wrongful discharge if he can establish, among other things, that his termination violated clearly defined public policy of the state.

4. Colleges and Universities ⇌8.1(3)

Terminated at-will custodian at Iowa community college had not engaged in ac-

EXHIBIT N

EXHIBIT N - 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI - SOCIETA)	
PER AZIONI)	
)	
Applicant.)	

APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases, Applicant, Barilla G.E R. Fratelli - Societa Per Azioni ("Barilla"), propounds the following requests for admission to Opposer, American Italian Pasta Company ("AIPC") for which responses are to be served on Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof.

For purposes of these Requests, the following Definitions and Instructions are set forth below.

For the convenience of the parties and the Board, each Request for Admission should be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word “person” or “entity” shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term “Opposer”, “AIPC”, “you” or “your” shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan “AMERICA’S FAVORITE PASTA” as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. All references in these requests for admission to Opposer’s Mark means the term, mark or slogan “AMERICA’S FAVORITE PASTA” *per se*, as shown in Application Serial No. 76/497,489 and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols or designs, including, but not limited to an American flag.
- d. Whenever used herein, the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive (“or”) shall be deemed to include the conjunctive (“and”), and the conjunctive (“and”) shall be deemed to include the disjunctive (“or”); and each of the functional words “each,” “every,” “any,” and “all” shall be deemed to include each of the other functional words.

REQUESTS

Request No. 1:

One definition of the term FAVORITE is "liked or preferred above all others" (quoted from *Webster's II New College Dictionary* (Houghton Mifflin 2001)).

Request No. 2:

Opposer's Mark has never been used by AIPC on packaging or advertising where the word MUELLER'S does not also appear in prominent type.

Request No. 3:

AIPC does not and has not ever promoted Opposer's Mark without reference to the MUELLER's brand of pasta products.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron


G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: September 9, 2004

CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of September, 2004, I served the foregoing
APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS by causing a true copy
thereof to be sent, in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Robert DiGiovanni

admissionreq1

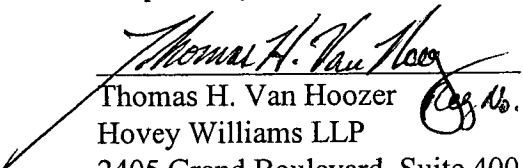
EXHIBIT N - 2

ANSWER

Admitted.

Dated: October 14, 2004

Respectfully submitted,


Thomas H. Van Hoozer *Cef. No. 32,761*
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone: (816) 474-9050
Facsimile: (816) 474-9057

CERTIFICATE OF SERVICE

I hereby certify that on the 14th day of October, 2004, I served the foregoing OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS by causing a true copy thereof to be sent via first class, postage paid, to the following:

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005



Thomas H. Van Hoozer

EXHIBIT N - 3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI - SOCIETA)	
PER AZIONI,)	
)	
Applicant.)	

APPLICANT'S FIRST SET OF INTERROGATORIES

Pursuant to Rules 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AIPC"), serve upon Applicant sworn answers to the interrogatories set forth below at the offices of Rothwell, Figg, Ernst & Manbeck, 1425 K Street, N.W., Suite 800, Washington, D.C. 20005, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or related materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of the Applicant through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the parties, Applicant requests that each discovery request (including subparts) be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC," "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of document and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of Opposer or its employees or agents, or known to Opposer to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any

documents bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document. In the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

d. In the following discovery requests, where identification of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34 of the Federal Rules of Civil Procedure and should include without limitation the following information, namely:

- i. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy of and the location of each such copy;

viii. for each document Opposer contends is privileged or otherwise excludable from discovery, the basis or such claim of privilege or other grounds for exclusion; and

ix. whether Opposer is willing to produce such document voluntarily to Barilla for inspection and copying.

e. In the following discovery requests, where identification of a person, as defined, is required, state:

i. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which) and/or present or last known (designating which) affiliation with Opposer, if any. In the case of a present or past employee, officer or director or agent of Opposer, also state the person's period of employment or affiliation with Opposer, and his or her present or last position during his affiliation with Opposer.

f. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

g. All references in these discovery requests to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA", *per se*, as shown in Application Serial No. 76/497,489, and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols, or designs, including, but not limited to, an American Flag.

h. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include each of the other functional words.

i. The terms "state" or "describe" (as used with respect to the specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to Opposer concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

INTERROGATORIES

Interrogatory No. 1.

Identify the officer(s) or employee(s) of AIPC primarily responsible for the sales and marketing of goods under Opposer's Mark.

Interrogatory No. 2.

Identify and describe each pasta item ever sold by IPC or on its behalf under Opposer's Mark.

Interrogatory No. 3.

State the exact date on which Opposer will rely as the first date of use of Opposer's Mark in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

Interrogatory No. 4.

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 3.

Interrogatory No. 5.

State the exact date on which Opposer will rely as the first date of use of the term AMERICA'S FAVORITE in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

Interrogatory No. 6.

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 5.

Interrogatory No. 7.

With respect to each pasta item identified in response to Interrogatory No. 2, state:

- (a) The manner in which Opposer's Mark is used, *e.g.*, by affixation to packaging, on labels, etc.;

- (b) Whether AIPC itself ever manufactured the pasta item and, if not, the identity of the manufacturer;
- (c) Whether the sale of the pasta item has been continuous from January 1, 1997 through present;
- (d) If the answer to subparagraph (c) is in the negative, state the periods of time for which Opposer's Mark was not used.

Interrogatory No. 8.

List all geographical areas (by city and/or state) in which each pasta item specified in response to Interrogatory No. 2 is distributed and/or sold under Opposer's Mark.

Interrogatory No. 9.

Identify all media which AIPC or its licensee has utilized to advertise or promote each pasta item specified in response to Interrogatory No. 2.

Interrogatory No. 10.

For each calendar year since 1997 state the amount expended by Opposer in connection with the advertising or promotion in the U.S. of each pasta item specified in response to Interrogatory No. 2 and sold under Opposer's Mark.

Interrogatory No. 11.

For each calendar year since 1997, state the amount of sales (by dollar or volume), by Opposer or its licensee, of each item of pasta specified in response to Interrogatory No. 2, or item bearing Opposer's Mark.

Interrogatory No. 12.

Identify by name and address all persons, organizations or agencies responsible for advertising each pasta item specified in response to Interrogatory No. 2 bearing Opposer's Mark.

Interrogatory No. 13.

State all facts that support the claim that the Mueller's Brand is "AMERICA'S FAVORITE PASTA" and identify any documents sufficient to support such facts.

Interrogatory No. 14.

State all facts that support your allegation that Barilla filed its application for the mark BARILLA - AMERICA'S FAVORITE PASTA "with notice and knowledge of the prior rights and use of Opposer's AMERICA'S FAVORITE PASTA Marks in connection with pasta products" and identify any documents sufficient to support such facts.

Interrogatory No. 15.

State the earliest date that Opposer was aware of Barilla's intent-to-use BARILLA - AMERICA'S FAVORITE PASTA in connection with pasta products.

Interrogatory No. 16.

Identify all persons who participated in any way in the preparation of the answers or responses to these Interrogatories and state specifically, with reference to Interrogatory numbers, the area of participation of each such person.

Respectfully submitted,

BARILLA G.E.R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: September 9, 2004

CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of September, 2004, I served the foregoing
APPLICANT'S FIRST SET OF INTERROGATORIES by causing a true copy thereof to be sent,
in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Robert DiGiovanni

interrog1

EXHIBIT N - 4

3. Opposer's answers to these interrogatories are subject to the General Objections as well as the objections made to each specific interrogatory. To extent these General Objections are applicable, they are incorporated by reference into each of Opposer's answers and by responding to certain of Applicant's interrogatories, Opposer does not waive these General Objections or any specific objections to particular requests. Opposer will produce requested information where otherwise appropriate. However, Opposer reserves its right to object to the admission of such information or documents at trial.

4. Opposer objects to each interrogatory to the extent that it calls for a legal conclusion.

5. Opposer objects to the production of information equally available to Applicant from third-party sources.

6. Opposer objects to the Applicant's interrogatories on the grounds that they are overly broad and unduly burdensome, seek information and documents which are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence, and to the extent they seek to impose obligations on Opposer beyond those required by the Trademark Trial and Appeal Board Rules and Federal Rules of Civil Procedure.

7. Opposer objects to Applicant's interrogatories on the grounds that they are overly broad in time and scope.

8. Opposer's responses to these interrogatories do not waive any attorney-client privilege or work product protection, nor does it waive any right to challenge the use of any such information at trial or other proceeding in this action.

9. Opposer objects to these interrogatories to the extent that they seek confidential commercial information and trade secrets of Opposer or its predecessors in interest. Upon entry of a suitable protective order, Opposer will supplement its answers as appropriate.

RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES

INTERROGATORY NO. 1

Identify the officer(s) or employee(s) of AIPC primarily responsible for the sales and marketing of goods under Opposer's Mark.

ANSWER

Opposer objects to this interrogatory as being overly broad, unduly burdensome, and vague and ambiguous as requiring identification of officers and employees primarily responsible for sales and marketing. Notwithstanding the foregoing objection, Opposer identifies the following officers and employees of Opposer which have principal responsibilities in connection with sales and marketing of its pasta items bearing Opposer's Mark: Tim Webster, President & CEO; Dan Trott, Executive Vice President Sales & Marketing; Walt George, Executive Vice President Operations & Supply Chain; Neal Clute, Director of Purchasing & Packaging Development; Celeste Wegner, Director, Packaging Services; Drew Lericos, Director of Marketing, all located at American Italian Pasta Company, 4100 North Mulberry Drive, Kansas City, MO 64116, but may be reached through Opposer's counsel.

INTERROGATORY NO. 2

Identify and describe each pasta item ever sold by AIPC or on its behalf under Opposer's Mark.

ANSWER

Opposer objects to this interrogatory as vague, overly broad in time and scope and unduly burdensome, and not relevant to the present dispute. Notwithstanding the foregoing objection, and subject to supplementation as additional information is discovered, Opposer identifies the following

styles and packaging sizes currently known to Opposer where the mark AMERICA'S FAVORITE

PASTA is or has been used on the packaging for the goods:

Bowties	12oz, 96 oz
Elbows	64 oz, 48oz, 32oz, 16oz, 8oz
Ridged Elbows	16oz
Mostaccioli	16oz
Tri Color Bowties	12oz
Tri Color Ruffles	12oz
Tri Color Shells	16oz
Tri Color Twists	12oz
Tri Color Rotini	12 oz.
Spaghetti	16oz, 8oz, 32oz, 48 oz.
Fine Linguine	16oz
Rotini	16oz
Gemelli	16oz
Jumbo Shells	12oz
Thin Spaghetti	16oz, 8oz, 32oz, 48oz
Angel Hair	16oz
Vermicelli	8oz, 16oz
Mini Penne	16oz, 500g
Ruffles	16oz, 96 oz.
Small Sea Shells	16oz, 96 oz.
Ziti	16oz

Lasagna	8oz
Linguine	16oz
Corkscrews	16oz
Rigatoni	16oz, 96 oz
Sea Shells	16oz
Ready Cut	16oz
Rotini Twists	16oz
Fettuccine	16oz
Ridge Mostaccioli	16oz, 96 oz.
Penne Rigate	16oz
Rotelle	16 oz.
Lasagne (smooth)	16 oz.
Reduced Carb Spaghetti/Penne	
Reduced Carb Spaghetti	12 oz.
Reduced Carb Elbows	12 oz.
Reduced Carb Penne	12 oz.
Reduced Carb Rotini	12 oz.
Reduced Carb Lasagne	16 oz.
Reduced Carb Variety Pack	
Reduced Carb Mixed Case	
Radiatore	500g
Back to Basics	

INTERROGATORY NO. 3

State the exact date on which Opposer will rely as the first date of use of Opposer's Mark in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and requiring the provision of information protected from disclosure as attorney work product. Notwithstanding the foregoing, and subject to supplementation as additional information is discovered, Opposer identifies the following information concerning the first known usages:

May 31, 1989 on promotional materials,

September, 1997 - on packaging for the goods.

INTERROGATORY NO. 4

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 3.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and requiring the provision of information protected from disclosure as attorney work product. Notwithstanding the foregoing, and subject to supplementation as additional information is discovered, Opposer identifies the following information concerning the first known usages:

Opposer's coupon with a May 31, 1989 expiration date; and

Mueller's Elbows package date stamped 1997.

INTERROGATORY NO. 5

State the exact date on which Opposer will rely as the first date of use of the term AMERICA'S FAVORITE in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and requiring the provision of information protected from disclosure as attorney work product. Notwithstanding the foregoing, Opposer identifies the following information concerning the first known usages of AMERICA'S FAVORITE by Opposer or its predecessors in interest. 1950's, use of AMERICA'S FAVORITE on Mueller's Elbows packaging, May 31, 1989, Coupon for Mueller's pasta using AMERICA'S FAVORITE PASTA; September 1997, Mueller's Elbows package using AMERICA'S FAVORITE PASTA.

INTERROGATORY NO. 6

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 5.

ANSWER

Opposer objects to this Interrogatory as being overly broad and unduly burdensome, and requiring the provision of information protected from disclosure as attorney work product. Notwithstanding the foregoing, Opposer answers as follows: Recipe book from 1950's showing use of AMERICA'S FAVORITE on Mueller's Elbows packaging, coupon with expiration date of May 31, 1989 using AMERICA'S FAVORITE PASTA, MUELLER'S Elbows box date coded 1997 showing use of AMERICA'S FAVORITE PASTA on packaging.

INTERROGATORY NO. 7

With respect to each pasta item identified in response to Interrogatory No. 2, state:

- (a) The manner in which Opposer's Mark is used, *e.g.*, by affixation to packaging, on labels, etc.;
- (b) Whether AIPC itself ever manufactured the pasta item and, if not, the identity of the manufacturer;
- (c) Whether the sale of the pasta item has been continuous from January 1, 1997 through the present;
- (d) If the answer to subparagraph (c) is in the negative, state the periods of time for which the Opposer's Mark was not used.

ANSWER

Opposer objects to this interrogatory as overly broad and unduly burdensome, and not relevant to the present opposition proceeding. Notwithstanding the foregoing, Opposer answers as follows:

- (a) On packaging and in advertising and promotional materials in connection with the goods;
- (b) Yes;
- (c) Yes;
- (d) Irrelevant to the proceedings herein.

INTERROGATORY NO. 8

List all geographical areas (by city and/or state) in which each pasta item specified in response to Interrogatory No. 2 is distributed and/or sold under Opposer's Mark.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and not relevant to this opposition proceeding. Notwithstanding the foregoing, Opposer advises that its pasta items sold under Opposer's Mark are sold throughout the United States, although distribution of its products under Opposer's Mark are primarily limited to military commissaries and mass merchandise stores in areas west of the Mississippi River.

INTERROGATORY NO. 9

Identify all media which AIPC or its license has utilized to advertise or promote each pasta item specified in response to Interrogatory No. 2.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and not relevant to the present opposition proceedings. Notwithstanding the foregoing, and subject to supplementation, promotional use by Opposer and its predecessors in interest includes presentation on packaging, on coupons, television and radio advertising, and website advertising.

INTERROGATORY NO. 10

For each calendar year since 1997, state the amount expended by Opposer in connection with the advertising or promotion in the U.S. of each pasta item specified in response to Interrogatory No. 2 and sold under Opposer's Mark.

ANSWER

AIPC incorporates by references is General Objections. AIPC further objects to the extent that the interrogatory is irrelevant to the claims and defenses of the parties. AIPC objects that the

interrogatory seeks highly confidential business and commercial information. Subject to these and the general objections, and to the extent such information is available, AIPC will provide responsive and relevant information after entry of a suitable protective order.

INTERROGATORY NO. 11

For each calendar year since 1997, state the amount of sales (by dollar or volume), by Opposer or its licensee, of each item of pasta specified in response to Interrogatory No. 2, or item bearing Opposer's Mark.

ANSWER

AIPC incorporates by references is General Objections. AIPC further objects to the extent that the interrogatory is irrelevant to the claims and defenses of the parties. AIPC objects that the request seeks highly confidential business and commercial information. Subject to these and the general objections, AIPC will provide responsive and relevant information, to the extent available, after entry of a suitable protective order.

INTERROGATORY NO. 12

Identify by name and address all persons, organizations or agencies responsible for advertising each pasta item specified in response to Interrogatory No. 2 bearing Opposer's Mark.

ANSWER

Opposer objects to this interrogatory as overly broad, unduly burdensome, and not relevant to the present opposition proceedings, and requesting confidential commercial information. Notwithstanding the foregoing, Opposer identifies the advertising agencies of Barkley & Evergreen,

432 W. 8th Street, Kansas City, Missouri 64105, and PowerPact LLC, 2902 Polo Parkway, Midlothian, VA 23113, who have assisted Opposer in developing advertising for the pasta products sold under Opposer's mark.

INTERROGATORY NO. 13

State all facts that support the claim that the Mueller's Brand is "AMERICA'S FAVORITE PASTA" and identify any documents sufficient to support such facts.

ANSWER

Opposer objects to this interrogatory as incorrectly assuming that Opposer is making a factual claim. Opposer is not making a factual claim regarding its trademark AMERICA'S FAVORITE PASTA. Opposer's use of AMERICA'S FAVORITE PASTA is an opinion. See Opposer's packaging and the decision of the 8th Circuit Court of Appeals in American Italian Pasta Company v. New World Pasta Company. Opposer's opinion and use of the trademark AMERICA'S FAVORITE PASTA is based on the long brand heritage of the Mueller's pasta products, its made in America quality, its family tradition of use. (*Webster Declaration of 13 Nov 2002, paragraph 19*)

INTERROGATORY NO. 14

State all facts that support your allegation that Barilla filed its application for the mark BARILLA - AMERICA'S FAVORITE PASTA "with notice and knowledge of the prior rights and use of Opposer's AMERICA'S FAVORITE PASTA Marks in connection with pasta products" and identify any documents sufficient to support such facts.

ANSWER

Objections: overly broad, unduly burdensome, attorney-client and work product. Subject to those objections, Opposer anticipates the development of additional facts concerning Applicant's

knowledge during the course of discovery. At present, Opposer identifies the packaging of Opposer's pasta products and its advertising and promotional materials bearing the mark in response to this interrogatory.

INTERROGATORY NO. 15

State the earliest date that Opposer was aware of Barilla's intent-to-use BARILLA - AMERICA'S FAVORITE PASTA in connection with pasta products.

ANSWER

Opposer objects to this interrogatory as calling for the provision of information privileged from discovery by the attorney-client privilege and as attorney work product. Subject to the foregoing, Opposer was aware of the intent-to-use application of Applicant for BARILLA - AMERICA'S FAVORITE PASTA on November 13, 2002.

INTERROGATORY NO. 16

Identify all persons who participated in any way in the preparation of the answers or responses to these Interrogatories and state specifically, with reference to Interrogatory numbers, the area of participation of each such person.

ANSWER

Other than assistance provided to Opposer by Opposer's counsel and staff, Drew Lericos.

2004-Oct-14 04:45pm From-

T-223 P.014/091 F-570

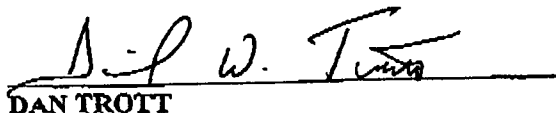
VERIFICATION

STATE OF _____)

) ss.

COUNTY OF _____)

Dan Trott hereby certifies that he is Executive Vice President Sales & Marketing of Opposer, and that he understands that he is answering these interrogatories on behalf of Opposer, and that the answers given to the above and foregoing interrogatories are true and correct to the best of his knowledge and belief.

Dated: 10/14/04
DAN TROTT

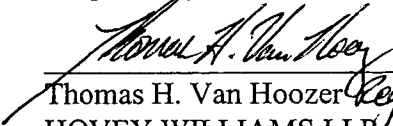
The foregoing Responses to Interrogatories were subscribed and sworn to before me this
_____ day of _____, 2004

Notary PublicMy Commission Expires:

AS TO THE OBJECTIONS:

Dated: October 14, 2004

Respectfully submitted,


Thomas H. Van Hoozer *Reg No. 32,761*
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone: (816) 474-9050
Facsimile: (816) 474-9057

CERTIFICATE OF SERVICE

I hereby certify that on the 14th day of October, 2004, I served the foregoing OPPOSER'S ANSWERS TO APPLICANT'S FIRST SET OF INTERROGATORIES by causing a true copy thereof to be sent via first class, postage paid, to the following:

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005

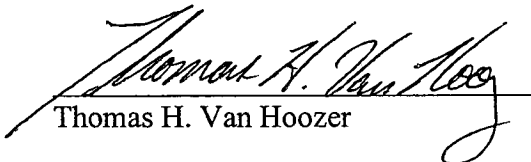

Thomas H. Van Hoozer

EXHIBIT N - 5

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI- SOCIETA)	
PER AZIONI,)	
)	
Applicant.)	

**APPLICANT'S FIRST SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005. c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

A. The Definitions and Instructions in Applicant's First Set of Interrogatories are incorporated herein by reference.

B. If Opposer knows of the existence, past or present, of any document or thing requested herein, but is unable to produce such document or thing because it is not presently in

the possession, custody or control of Opposer, AIPC is requested to identify such document or thing in the same manner set forth in paragraph C hereof.

C. In the event that Opposer contends that any document or thing requested is privileged or otherwise excluded from discovery, Opposer is requested to specify the basis of the privilege or other grounds for exclusion and to identify the document or thing by stating the date, time, title, author and recipient of the document or thing; the type of document or thing; and the present or last known custodian of the document or thing.

D. The following requests are deemed to be continuing pursuant to Fed.R.Civ.P. 26(e) so that with respect to any request herein, or part thereof, as to which Opposer, after responding, discovers additional responsive documents or things, Barilla requests that Opposer produce such documents or things within thirty (30) days after acquiring knowledge of their existence, or advise Barilla in writing as to why such additional documents or things cannot be produced within the specified period.

E. Each document or thing should be labeled or otherwise produced in such a way that the file in which the document or thing is maintained in the normal course of Opposer's business can be easily determined. Alternatively, the documents or things produced shall be organized and labeled to correspond to the category specified in the requests as required by Fed.R.Civ.P. 34.

F. Documents which are bound or fastened together shall be bound or fastened together in that same fashion at the time of production.

REQUESTS

Request No. 1:

All documents requested to be identified in Barilla's First Set of Interrogatories to Opposer.

Request No. 2:

Representative samples of all advertisements, press releases, brochures, price lists, catalogs, newspapers, magazine and trade articles, and other promotional materials containing or bearing each form of Opposer's Mark for use or intended use.

Request No. 3:

For each year since 1997, representative samples of each form of affixation or association of Opposer's Mark to or with the pasta items identified in AIPC's Answer to Interrogatory No. 2 of Barilla's First Set of Interrogatories (*e.g.*, samples of each and every type of label, package, product or tag which bears each form of Opposer's Mark).

Request No. 4:

All licenses, agreements, contracts, assignments or consents to use naming AIPC or any predecessor-in-interest, including but not limited to BEST FOODS and/or UNILEVER as a party and relating to the use of AMERICA'S FAVORITE PASTA in connection with any pasta items specified in response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

Request No. 5:

All documents received from third parties, including any state or federal agencies, concerning AIPC's use of Opposer's Mark on its packaging of pasta products.

Request No. 6:

All documents concerning Opposer's awareness of Barilla, Barrila's trademark application for BARILLA - AMERICA'S FAVORITE PASTA, or any pasta products provided by Barilla in the U.S.

Request No. 7:

All documents concerning or showing confusion in the U.S., including, without limitation, misdirected mail, records of misdirected telephone calls or inquiries, between Barilla's Mark BARILLA - AMERICA'S FAVORITE PASTA and Opposer's Mark or confusion in the U.S. between goods manufactured, sold or distributed by Barilla bearing any designation BARILLA - AMERICA'S FAVORITE PASTA and goods manufactured, sold or distributed by Opposer or confusion in the U.S. as to the source of the parties' goods.

Request No. 8:

All documents and things that reflect, evidence, or concern the degree of public recognition of Opposer's Mark in the U.S., including but not limited to market research, polls, or surveys conducted by or caused to be conducted or obtained by Opposer.

Request No. 9:

All documents which relate to: (a) the meaning or significance of Opposer's Mark; or (b) consumers' awareness or understanding of Opposer's Mark.

Request No. 10:

All documents referring or relating to any actual or threatened proceedings (*e.g.*, lawsuits, oppositions, cancellations, etc.) involving a mark consisting in whole or in part of the words "AMERICA'S FAVORITE PASTA" in which Opposer has ever been involved, which

concerns allegations of trademark, service mark, trade name or trade dress infringement or unfair competition based on improper use of a trademark, service mark, trade name, trade dress or any other source identifier.

Request No. 11:

All documents referring or relating to any and all searches or investigations (*e.g.*, on a federal, state or common law basis) which have been conducted concerning Opposer's Mark, including documents referring or relating to any such searches or investigations concerning all marks ever considered by Opposer as possible alternatives to Opposer's Mark.

Request No. 12:

All documents referring or relating to Opposer's consideration, selection and/or adoption of Opposer's Mark, including documents referring or relating to any alternatives to said mark considered by Opposer.

Request No. 13:

All documents referring or relating to Opposer's decision to apply to register Opposer's Mark with the U.S. Patent and Trademark Office.

Request No. 14:

Each business, marketing, advertising or media plan prepared by or on behalf of AIPC which refers or relates in any way to Opposer's Mark.

Request No. 15:

All documents evidencing AIPC's knowledge of third party marks having the designation "AMERICA'S FAVORITE" in whole or in part for any food products.

Request No. 16:

Those documents which support, rebut or otherwise relate to AIPC's claim that any pasta products it sells or sold in the U.S. are literally "AMERICA'S FAVORITE PASTA."

Request No. 17:

All documents and things which reflect, refer to, relate to or evidence a discontinued or interrupted use of Opposer's Mark by AIPC, after its first use, for any of the pasta items specified in Response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

Request No. 18:

All documents and things which reflect, refer to, relate to or concern any advertising or public relation firm activity, including correspondence, for AIPC's goods sold under Opposer's Mark from 2000 through present.

Request No. 19:

All documents referring or relating to or evidencing any standards or guidelines to be followed by you or any other entity for use of Opposer's Mark on packaging of pasta products.

Request No. 20

All documents showing use of any kind by any third party of the phrases "America's
Favorite Pasta."

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

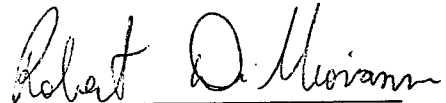
G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: September 9, 2004

CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of September, 2004, I served the foregoing
APPLICANT'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Robert DiGiovanni

docreq1

EXHIBIT N - 6

**AMERICAN ITALIAN PASTA
COMPANY**

Opposer,

V.

**BARILLA G. E R. FRATELLI-SOCIETA
PER AZIONI,**

Applicant.

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OPPOSITION NO.: 91-161,373

SERIAL NO.:

MARK:

OPPOSER'S RESPONSES TO APPLICANT'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS

Pursuant to 37 C.F.R. § 2.120 and Rule 34 of the Federal Rules of Civil Procedure, Opposer, American Italian Pasta Company (“Opposer”) makes the following responses and objections to Applicant’s First Set of Requests for Production of Documents.

PRELIMINARY STATEMENT

Opposer's search for information and documentation in connection with these requests was conducted with the necessary degree of diligence to locate responsive information and documents. Opposer reserves the right to revise, correct, add to, supplement, or clarify any of its answers to Applicant's requests as may be necessary.

GENERAL OBJECTIONS

1. Opposer objects to Applicant's requests to the extent that they seek information subject to the attorney-client privilege or other privilege.

2. Opposer objects to each request to the extent it seeks information which have been prepared in anticipation of litigation or for trial, or otherwise subject to protection under the work product doctrine or Rule 26(b)(3) of the Federal Rules of Civil Procedure.

3. Opposer answers to these requests are subject to the General Objections as well as the objections made to each specific request. To the extent these General Objections are applicable, they are incorporated by reference into each of Opposer's answers and by responding to certain of Applicant's requests, Opposer does not waive these General Objections or any specific objections to particular requests. Opposer will produce requested information where otherwise appropriate. However, Opposer reserves its right to object to the admission of such information or documents at trial.

4. Opposer objects to each request to the extent that it calls for a legal conclusion.

5. Opposer objects to the production of information equally available to Applicant from third party sources.

6. Opposer objects to the Applicant's requests on the grounds that they are overly broad and unduly burdensome, seek information and documents which are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence, and to the extent they seek to impose obligations on Opposer beyond those required by the Trademark Trial and Appeal Board Rules and Federal Rules of Civil Procedure.

7. Opposer's responses to these requests do not waive any attorney-client privilege or work product protection, nor does it waive any right to challenge the use of any such information at trial or other proceeding in this action.

8. Opposer objects to these interrogatories to the extent that they seek confidential commercial information and trade secrets of Opposer or its predecessors in interest. Upon entry of a suitable protective order, Opposer will supplement its answers as appropriate.

9. Opposer incorporates herein by reference its objections as set forth in Opposer's Answers to Applicant's First Set of Interrogatories.

RESPONSES TO REQUESTS FOR DOCUMENTS

REQUEST NO. 1

All documents requested to be identified in Barilla's First Set of Interrogatories to Opposer.

ANSWER

Opposer objects to this Request as overly broad, unduly burdensome, not relevant to the present opposition proceedings, and requesting documents protected from discovery by the attorney-client privilege and as attorney work product. Notwithstanding the foregoing, see documents identified and produced with Opposer's Response to Applicant's First Set of Interrogatories. Those to be produced subject to Protective Order will be produced when such Protective Order is in place.

REQUEST NO. 2

Representative samples of all advertisements, press releases, brochures, price lists, catalogs, newspapers, magazine and trade articles, and other promotional materials containing or bearing each form of Opposer's Mark for use or intended use.

ANSWER

AIPC objects to this request as being vague, overly broad in time and scope, and unduly burdensome in seeking "all" materials. Subject to these and the general objections, relevant, representative, and responsive documents will be produced.

REQUEST NO. 3

For each year since 1997, representative samples of each form of affixation or association of Opposer's Mark to or with the pasta items identified in AIPC's Answer to Interrogatory No. 2 of Barilla's First Set of Interrogatories (*e.g.*, samples of each and every type of label, package, product or tag which bears each form of Opposer's Mark).

ANSWER

AIPC objects to this request as being overly broad in time and scope and unduly burdensome in seeking "each and every type" of label, package, produce or tag. Subject to these and the general objections, relevant, representative, and responsive documents will be produced.

REQUEST NO. 4

All licenses, agreements, contracts, assignments or consents to use naming AIPC or any predecessor-in-interest, including but not limited to BEST FOODS and/or UNILEVER as a party and relating to the use of AMERICA'S FAVORITE PASTA in connection with any pasta items specified in response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

ANSWER

AIPC objects to this request as being overly broad and unduly burdensome in seeking "all" licenses, agreements, contracts, assignments or consents to use. AIPC also objects that the request seeks highly confidential business and commercial information. Subject to these and the general objections, relevant, responsive documents will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 5

All documents received from third parties, including any state or federal agencies, concerning AIPC's use of Opposer's Mark on its packaging of pasta products.

ANSWER

AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents "concerning" AIPC's use of Opposer's Mark, as requesting virtually every document in Opposer's possession concerning its manufacturing, marketing, or sales of Mueller's pasta products. Subject to these and the general objections, relevant, representative responsive documents will be produced.

REQUEST NO. 6

All documents concerning Opposer's awareness of Barilla, Barilla's trademark application for BARILLA - AMERICA'S FAVORITE PASTA, or any pasta products provided by Barilla in the U.S.

ANSWER

AIPC objects to the extent this request seeks attorney-client privileged communications or attorney work product. AIPC objects that the request seeks highly confidential business information. AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Subject to these and the general objections, relevant, responsive documents will be produced upon the entry of a suitable Protective Order. Notwithstanding such objection, Opposer will produce a copy of its November 13, 2002 Suggestions in Opposition to New World Pasta's Motion for Summary Judgment which references Applicant's application.

REQUEST NO. 7

All documents concerning or showing confusion in the U.S., including, without limitation, misdirected mail, records of misdirected telephone calls or inquiries, between Barilla's Mark BARILLA - AMERICA'S FAVORITE PASTA and Opposer's Mark or confusion in the U.S. between goods manufactured, sold or distributed by Barilla bearing any designation BARILLA - AMERICA'S FAVORITE PASTA and goods manufactured, sold or distributed by Opposer or confusion in the U.S. as to the source of the parties' goods.

ANSWER

AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Subject to these and the general objections, relevant, responsive documents, if any, will be produced. To the best of Opposer's present knowledge, however, there are no documents in its possession, custody or control which are responsive to this Request.

REQUEST NO. 8

All documents and things that reflect, evidence, or concern the degree of public recognition of Opposer's Mark in the U.S., including but not limited to market research polls, or surveys conducted by or caused to be conducted or obtained by Opposer.

ANSWER

AIPC objects to the extent this request seeks attorney-client privileged communications or attorney work product. AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. AIPC objects that the request seeks highly confidential business and commercial information. Subject to these and the general objections, see responses to Requests No. 2, 3, 4; also, Opposer will produce other relevant, responsive documents, subject to the entry of a suitable protective order.

REQUEST NO. 9

All documents which relate to: (a) the meaning or significance of Opposer's Mark; or (b) consumers' awareness or understanding of Opposer's Mark.

ANSWER

AIPC objects to the extent this request seeks attorney-client privileged communications or attorney work product. AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. AIPC objects that the request seeks highly confidential business and commercial information. Subject to these and the general objections, see responses to Request No. 2, 3, 6 and 8; to the extent that other non-objectionable, relevant, and responsive documents are located, they will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 10

All documents referring or relating to any actual or threatened proceedings (*e.g.*, lawsuits, oppositions, cancellations, etc.) involving a mark consisting in whole or in part of the words "AMERICA'S FAVORITE PASTA" in which the Opposer has ever been involved, which concerns allegations of trademark, service mark, trade name or trade dress infringement or unfair competition based on improper use of a trademark, service mark, trade name, trade dress or any other source identifier.

ANSWER

Opposer objects to the extent this request seeks attorney-client privileged communications or attorney work product, and as being overly broad and unduly burdensome. Opposer objects that the request seeks confidential business information. Notwithstanding the foregoing, Opposer will produce copies of the submissions to the U.S. District Court for the Western District of Missouri and the 8th Circuit Courts of Appeal, which were not subject to a Protective Order and the decisions of

those Courts concerning the case of *American Italian Pasta Company v. New World Pasta Company*, Civil Action No. 02 0594 CV W SOW.

REQUEST NO. 11

All documents referring or relating to any and all searches or investigations (*e.g.*, on a federal, state or common law bases) which have been conducted concerning Opposer's Mark, including documents referring or relating to any such searches or investigations concerning all marks ever considered by Opposer as possible alternatives to Opposer's Mark.

ANSWER

AIPC objects to the extent this request seeks attorney-client privileged communications or attorney work product, is overly broad and unduly burdensome. Opposer objects that the request seeks confidential business information. Subject to the documents produced responsive to Requests No. 6 and 10, Opposer is not aware of any such documents.

REQUEST NO. 12

All documents referring or relating to Opposer's consideration, selection and/or adoption of Opposer's Mark, including documents referring or relating to any alternatives to said mark considered by Opposer.

ANSWER

Opposer objects to this request as it is overly broad, unduly burdensome, and vague and ambiguous. Opposer objects to the extent that it seeks attorney-client privileged communications and attorney work product. Subject to those objections, and the General Objections, Opposer states it has no documents responsive to this request.

REQUEST NO. 13

All documents referring or relating to Opposer's decision to apply to register Opposer's Mark with the U.S. Patent and Trademark Office.

ANSWER

AIPC objects to the extent this request seeks attorney-client privileged communications or attorney work product. Opposer objects to this request insofar as it seeks documents equally available to the Applicant through the U.S. Patent and Trademark Office.

REQUEST NO. 14

Each business, marketing, advertising or media plan prepared by or on behalf of AIPC which refers or relates in any way to Opposer's Mark.

ANSWER

AIPC objects that the request seeks highly confidential business and commercial information. Subject to these and the general objections, relevant, responsive documents, if any, will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 15

All documents evidencing AIPC's knowledge of third party marks having the designation "AMERICA'S FAVORITE" in whole or part for any food products.

ANSWER

AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Opposer also objects to the production of any documents protected from disclosure by the attorney-client privilege or as attorney work product. Subject to these and the general objections, see response to Request No. 10.

REQUEST NO. 16

Those documents which support, rebut or otherwise relate to AIPC's claim that any pasta products it sells or sold in the U.S. are literally "AMERICA'S FAVORITE PASTA."

ANSWER

Applicant incorporates herein its objection to Interrogatory No. 13. Subject to this objection, see documents being produced responsive to Requests No. 2, 3, 8 and 10.

REQUEST NO. 17

All documents and things which reflect, refer to, relate to or evidence a discontinued or interrupted use of Opposer's Mark by AIPC, after its first use, for any of the pasta items specified in Response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

ANSWER

AIPC objects to this request as being overly broad, unduly burdensome in seeking "all" documents, as well as not reasonably calculated to lead to the discovery of admissible evidence. Subject to these and the general objections, relevant, responsive documents, if any, will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 18

All documents and things which reflect, refer to, relate to or concern any advertising or public relation firm activity, including correspondence, for AIPC's goods sold under Opposer's Mark from 2000 through present.

ANSWER

AIPC objects to this request in that it is vague and ambiguous in requesting all documents which relate to or concern any advertising or public relations activity. As best understood, the

request is sufficiently broad so as to require production of privileged documents, and Opposer, therefore, objects to the production of any documents constituting attorney-client privileged communications or attorney work product. AIPC further objects in that the request seeks highly confidential business and commercial information. AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Subject to these and the general objections, and to the extent the request is understood, relevant, and responsive documents, if any, will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 19

All documents referring or relating to or evidencing any standards or guidelines to be followed by you or any other entity for use of Opposer's Mark on packaging of pasta products.

ANSWER

AIPC objects that the request seeks highly confidential business and commercial information. AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Subject to these and the general objections, relevant, responsive documents, if any, will be produced, subject to the entry of a suitable protective order.

REQUEST NO. 20

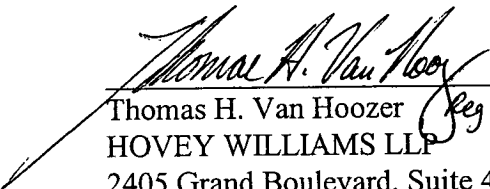
All documents showing use of any kind by any third party of the phrases "America's Favorite Pasta." To the extent such documents may exist and are known to the Opposer, they are included in the response to Request No. 10.

ANSWER

AIPC objects to this request as being overly broad, and unduly burdensome in seeking "all" documents. Subject to these and the general objections, relevant, responsive documents, if any, will be produced.

Dated: October 14, 2004

Respectfully submitted,


Thomas H. Van Hoozer *Reg. No. 32,761*
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone: (816) 474-9050
Facsimile: (816) 474-9057

CERTIFICATE OF SERVICE

I hereby certify that on the 14 day of October, 2004, I served the foregoing OPPOSER'S ANSWERS TO APPLICANT'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS by causing a true copy thereof to be sent via first class, postage paid, to the following:

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005

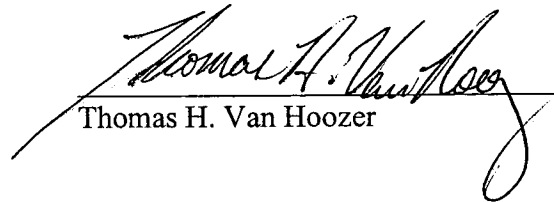

Thomas H. Van Hoozer

EXHIBIT N - 7

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI - SOCIETA)	
PER AZIONI,)	
)	
Applicant.)	

APPLICANT'S SECOND SET OF INTERROGATORIES

Pursuant to Rules 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AIPC"), serve upon Applicant sworn answers to the interrogatories set forth below at the offices of Rothwell, Figg, Ernst & Manbeck, 1425 K Street, N.W., Suite 800, Washington, D.C. 20005, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or related materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of the Applicant through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the parties, Applicant requests that each discovery request (including subparts) be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC," "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of document and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of Opposer or its employees or agents, or known to Opposer to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any

documents bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document. In the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

d. In the following discovery requests, where identification of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34 of the Federal Rules of Civil Procedure and should include without limitation the following information, namely:

- i. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy of and the location of each such copy;

viii. for each document Opposer contends is privileged or otherwise excludable from discovery, the basis or such claim of privilege or other grounds for exclusion; and

ix. whether Opposer is willing to produce such document voluntarily to Barilla for inspection and copying.

e. In the following discovery requests, where identification of a person, as defined, is required, state:

i. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which) and/or present or last known (designating which) affiliation with Opposer, if any. In the case of a present or past employee, officer or director or agent of Opposer, also state the person's period of employment or affiliation with Opposer, and his or her present or last position during his affiliation with Opposer.

f. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

g. All references in these discovery requests to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA", *per se*, as shown in Application Serial No. 76/497,489, and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols, or designs, including, but not limited to, an American Flag.

h. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include each of the other functional words.

i. The terms "state" or "describe" (as used with respect to the specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to Opposer concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

INTERROGATORIES

Interrogatory No. 17:

State the ordinary meaning of the word "favorite".

Interrogatory No. 18:

State the meaning of the word "favorite" in the context of Opposer's Mark.

Interrogatory No. 19:

With respect to any of Opposer's answers to Applicant's First and Second Set of Requests for Admission that were anything other than an unqualified admission, state in detail all facts and identify all documents and materials that support the answer.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

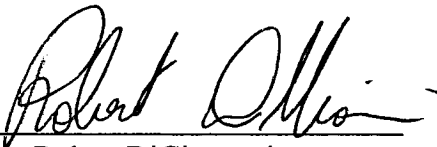
G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: February 22, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of February, 2005, I served the foregoing by causing a true copy thereof to be sent, in the manner indicated, **APPLICANT'S SECOND SET OF INTERROGATORIES**, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Robert DiGiovanni

L:\2778\2778-157L\Discovery\interrog2.wpd

EXHIBIT N - 8

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**AMERICAN ITALIAN PASTA
COMPANY**

Opposer,

v.

**BARILLA G. E R. FRATELLI-SOCIETA
PER AZIONI,**

Applicant.

**OPPOSITION NO.: 91-161,373
SERIAL NO.: 78//136,703**

OPPOSER'S ANSWERS TO APPLICANT'S SECOND SET OF INTERROGATORIES

Pursuant to 37 C.F.R. § 2.120 and Rule 33 of the Federal Rules of Civil Procedure, Opposer American Italian Pasta Company ("Opposer") makes the following responses and objections to Applicant's Second Set of Interrogatories.

PRELIMINARY STATEMENT

Opposer's search for information and documentation in connection with these interrogatories was conducted with the necessary degree of diligence to locate responsive information and documents. Opposer reserves the right to revise, correct, add to, supplement, or clarify any of its answers to Applicant's interrogatories as may be necessary.

GENERAL OBJECTIONS

1. Opposer objects to Applicant's interrogatories to the extent that they seek information subject to the attorney-client privilege or other privilege.
2. Opposer objects to each interrogatory to the extent it seeks information which have been prepared in anticipation of litigation or for trial, or otherwise subject to protection under the work product doctrine or Rule 26(b)(3) of the Federal Rules of Civil Procedure.

3. Opposer's answers to these interrogatories are subject to the General Objections as well as the objections made to each specific interrogatory. To extent these General Objections are applicable, they are incorporated by reference into each of Opposer's answers and by responding to certain of Applicant's interrogatories, Opposer does not waive these General Objections or any specific objections to particular requests. Opposer will produce requested information where otherwise appropriate. However, Opposer reserves its right to object to the admission of such information or documents at trial.

4. Opposer objects to each interrogatory to the extent that it calls for a legal conclusion.

5. Opposer objects to the production of information equally available to Applicant from third party sources.

6. Opposer objects to the Applicant's interrogatories on the grounds that they are overly broad and unduly burdensome, seek information and documents which are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence, and to the extent they seek to impose obligations on Opposer beyond those required by the Trademark Trial and Appeal Board Rules and Federal Rules of Civil Procedure.

7. Opposer's responses to these interrogatories do not waive any attorney-client privilege or work product protection, nor does it waive any right to challenge the use of any such information at trial or other proceeding in this action.

8. Opposer objects to these interrogatories to the extent that they seek confidential commercial information and trade secrets of Opposer or its predecessors in interest. Upon entry of a suitable protective order, Opposer will supplement its answers as appropriate.

RESPONSES TO APPLICANT'S SECOND SET OF INTERROGATORIES

INTERROGATORY NO. 17

State the ordinary meaning of the word "favorite."

ANSWER

Subject to the general objections set forth above, "markedly popular."

INTERROGATORY NO. 18

State the meaning of the word "favorite" in the context of Opposer's Mark.

ANSWER

Subject to the general objections set forth above, "markedly popular especially over an extended period of time."

INTERROGATORY NO. 19

With respect to any of Opposer's answers to Applicant's First and Second Set of Requests for Admission that were anything other than an unqualified admission, state in detail all facts and identify all documents and materials that support the answer.

ANSWER

Opposer objects to this Interrogatory as being overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of material evidence. Opposer further objects to this Interrogatory as it purports to impose upon it an obligation to investigate and discover information and materials from third parties or sources equally accessible to Applicant. Opposer further objects to this Interrogatory as it purports to seek information protected from discovery as attorney work-product or under the attorney client privilege. Subject to the foregoing, Opposer responds by indicating that it has denied those requests for admission either because they are untrue, or because

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T-330 P.005/011 F-709

they seek legal conclusions, or because they seek opinions rather than facts, or because Opposer does not have sufficient information to admit or deny the request, and therefore denies the same.

AMERICAN ITALIAN PASTA COMPANY

By J. & W. WhiteDate: March 29, 2005

they seek legal conclusions, or because they seek opinions rather than facts, or because Opposer does not have sufficient information to admit or deny the request, and therefore denies the same.

AMERICAN ITALIAN PASTA COMPANY

By _____

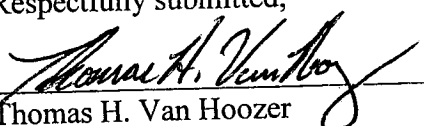
Tim Webster, President and Chief Executive Officer

Date: _____

As to the objections.

Dated: March 29, 2004

Respectfully submitted,


Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone: (816) 474-9050
Facsimile: (816) 474-9057

CERTIFICATE OF SERVICE

I hereby certify that on the 29th day of March, 2005, I served the foregoing OPPOSER'S ANSWERS TO APPLICANT'S SECOND SET OF INTERROGATORIES by causing a true copy thereof to be sent via first class, postage paid, to the following:

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005


Thomas H. Van Hoozer

EXHIBIT N - 9

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI- SOCIETA)	
PER AZIONI,)	
)	
Applicant.)	

**APPLICANT'S SECOND SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

The Definitions and Instructions in Applicant's First Set of Interrogatories and Requests for Production of Documents and Things are incorporated herein by reference.

REQUESTS

Request No. 21:

All documents requested to be identified in Barilla's Second Set of Interrogatories to Opposer.

Request No. 22:

All documents identified or relied upon in the Affidavit of Timothy S. Webster attached to Barilla's Second Set of Requests for Admission at Tab A.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

G. Franklin Rothwell

Robert H. Cameron

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

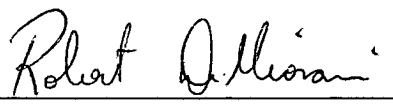
Facsimile: (202) 783-6031

Dated: February 22, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of February, 2005, I served the foregoing
APPLICANT'S SECOND SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Robert DiGiovanni

docreq2

EXHIBIT N - 10

2. Opposer objects to each request to the extent it seeks information which have been prepared in anticipation of litigation or for trial, or otherwise subject to protection under the work product doctrine or Rule 26(b)(3) of the Federal Rules of Civil Procedure.

3. Opposer answers to these requests are subject to the General Objections as well as the objections made to each specific request. To the extent these General Objections are applicable, they are incorporated by reference into each of Opposer's answers and by responding to certain of Applicant's requests, Opposer does not waive these General Objections or any specific objections to particular requests. Opposer will produce requested information where otherwise appropriate. However, Opposer reserves its right to object to the admission of such information or documents at trial.

4. Opposer objects to each request to the extent that it calls for a legal conclusion.

5. Opposer objects to the production of information equally available to Applicant from third party sources.

6. Opposer objects to the Applicant's requests on the grounds that they are overly broad and unduly burdensome, seek information and documents which are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence, and to the extent they seek to impose obligations on Opposer beyond those required by the Trademark Trial and Appeal Board Rules and Federal Rules of Civil Procedure.

7. Opposer's responses to these requests do not waive any attorney-client privilege or work product protection, nor does it waive any right to challenge the use of any such information at trial or other proceeding in this action.

8. Opposer objects to these interrogatories to the extent that they seek confidential commercial information and trade secrets of Opposer or its predecessors in interest. Upon entry of a suitable protective order, Opposer will supplement its answers as appropriate.

9. Opposer incorporates herein by reference its objections as set forth in Opposer's Answers to Applicant's First Set of Interrogatories.

RESPONSES TO REQUESTS FOR DOCUMENTS

REQUEST NO. 21

All documents requested to be identified in Barilla's Second Set of Interrogatories to Opposer.

RESPONSE

Opposer objects to this Request as overly broad, unduly burdensome, not relevant to the present opposition proceedings, and requesting documents protected from discovery by the attorney-client privilege and as attorney work product. Notwithstanding the foregoing, Opposer responds in that no documents were requested to be identified in Applicant's Second Set of Interrogatories and none are required to be produced.

REQUEST NO. 22

All documents identified or relied upon in the Affidavit of Timothy S. Webster attached to Barilla's Second Set of Requests for Admission at Tab A.

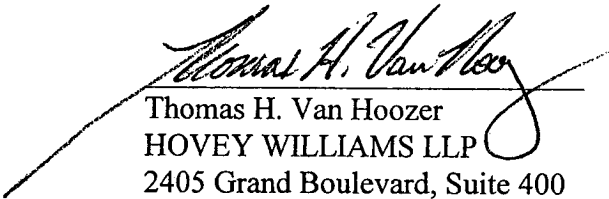
RESPONSE

Opposer objects to this Request as overly broad, unduly burdensome, not relevant to the present opposition proceedings, requesting documents already in the possession of Applicant or equally available to it, and requesting documents protected from discovery by the attorney-client

privilege and as attorney work product. Notwithstanding the foregoing, see the documents appended as Exhibits A, B, C, D, E, F and G to the Tim Webster affidavit of November 13, 2002.

Dated: March 29, 2005

Respectfully submitted,



Thomas H. Van Hoozer
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone: (816) 474-9050
Facsimile: (816) 474-9057

CERTIFICATE OF SERVICE

I hereby certify that on the 29th day of March, 2005, I served the foregoing OPPOSER'S ANSWERS TO APPLICANT'S SECOND SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS by causing a true copy thereof to be sent via first class, postage paid, to the following:

G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005



Thomas H. Van Hoozer

EXHIBIT O



Trademarks > Trademark Electronic Search System(Tess)

TESS was last updated on Sat Jan 28 04:10:43 EST 2006

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#) [PREV LIST](#) [CURR LIST](#) [NEXT LIST](#)
[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: OR [Jump](#) to record: **Record 3 out of 3**

[TARR Status](#) [ASSIGN Status](#) [TDR](#) [TTAB Status](#) (Use the "Back" button of the Internet
Browser to return to TESS)

★ ★ ★ ★ ★ ★ ★ ★ ★ ★
AMERICA'S FAVORITE PASTA

Word Mark	AMERICA'S FAVORITE PASTA
Goods and Services	IC 030. US 046. G & S: PASTA. FIRST USE: 20020500. FIRST USE IN COMMERCE: 20020500
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.01.03 - Comets; Stars with five points 01.01.10 - Stars, three or more; Three or more stars 24.09.05 - American flags; Flags, American 26.11.21 - Rectangles that are completely or partially shaded 26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal
Serial Number	76497190
Filing Date	March 14, 2003
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) American Italian Pasta Company CORPORATION MISSOURI 4100 N. Mulberry Drive, Suite 200 Kansas City MISSOURI 641161696
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Thomas H. Van Hoozer
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE PASTA APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)-IN PART
Live/Dead Indicator	LIVE
Distinctiveness Limitation Statement	as to "AMERICA'S FAVORITE PASTA"

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**MARK: AMERICA'S FAVORITE
PASTA AND DESIGN
CLASS: 29**

TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:

American Italian Pasta Company, a corporation duly organized under the laws of the State of
MISSOURI,

Business Address: 4100 N. Mulberry Drive, Suite 200, Kansas City, MO 64116-1696

Applicant requests registration of the above identified trademark shown in the accompanying drawing in the United States Patent and Trademark Office under Section 2(f) of the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended) for the following goods:

PASTA

Applicant believes that the mark has become distinctive of applicant's goods in interstate commerce with respect to the words AMERICA'S FAVORITE PASTA by reason of their substantially exclusive and continuous use thereof as a trademark by Applicant and its predecessor in interest in commerce for the five years before the date on which this claim of distinctiveness is made.

Applicant is using the mark in commerce on or in connection with the above identified goods. (15 U.S.C. 1051(a), as amended). Three specimens showing the mark as used in commerce are submitted with this application.

Date of first use of the mark anywhere: May, 2002

Date of first use of the mark in commerce which the

U.S. Congress may regulate: May, 2002

Type of commerce: Interstate

The mark is used by applying it to the goods.

Applicant hereby appoints the law firm of HOVEY WILLIAMS LLP, 2405 Grand Boulevard, Suite 400, Kansas City, Missouri 64108, telephone number 816-474-9050 as the address to whom all communications about this application are to be directed, and hereby appoints each of the following attorneys associated with said firm, and of the same address, individually and collectively, its attorneys, with full power of substitution and revocation, to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration: Robert D. Hovey, Warren N. Williams, Stephen D. Timmons, John M. Collins, Thomas H. Van Hoozer, Thomas B. Luebbering, Andrew G. Colombo, Tracy Bornman, Tracey S. Truitt, Scott R. Brown, Lara Dickey Lewis, and David V. Ayres, Gerhard P. Shipley, Kameron D. Kelly, Gregory J. Skoch, Leslie L. Lawson, Jennifer C. Bailey, Jason E. Gorden and William J. Jacob.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the mark sought to be registered, or, if the application is being filed under 15 U.S.C. 1051(b), he believes applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, to cause

confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

American Italian Pasta Company

Date: March 10, 2003

By Tim Webster
Tim Webster

(Docket No. 33315)

EXHIBIT P

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E R. FRATELLI- SOCIETA
PER AZIONI,

Applicant.

Opposition No. 91-161,373

**APPLICANT'S THIRD SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Carla C. Calcagno, within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

For purposes of these requests, Applicant adopts the Definitions and Instructions in Applicant's Third Set of Interrogatories to Opposer

For the convenience of the parties and the Board, each Request for Production should be quoted in full immediately preceding the response.

REQUESTS

Request No. 23:

Produce all documents in Opposer's possession, custody and control which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Request No. 24:

Produce all documents in Opposer's possession, custody and control, which Applicant did not produce, and which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Request No. 25:

Produce all documents in Opposer's possession, custody or control, which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Request No. 26:

Produce all studies, surveys or scientific reports which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Request No. 27:

Produce all studies, surveys or scientific reports which Opposer contends reflect the degree of likelihood of confusion between Opposer's use of the phrase AMERICA'S FAVORITE PASTA and Applicant's proposed use of Barilla – America's Favorite Pasta.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: 

G. Franklin Rothwell

Carla C. Calcagno

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

Facsimile: (202) 783-6031

Attorneys for the Applicants

Dated: November 1, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 1st day of NOVEMBER, 2005, I served the foregoing
APPLICANT'S THIRD SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Matthew Felten

docreq3

REQUESTS

Request No. 23:

Produce all documents in Opposer's possession, custody and control which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Response to Request No. 23: Subject to the General Objections, Opposer has previously produced responsive documents, except for the applications and prosecution histories of Application Serial Nos. 78/136708, 78/136706, and 78/0136701, and Applicant's discovery responses, which are already in Applicant's possession and to which Opposer objects to further production as duplicative.

Request No. 24:

Produce all documents in Opposer's possession, custody and control, which Applicant did not produce, and which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Response to Request No. 24: Subject to the General Objections, see response to Request No. 23.

Request No. 25:

Produce all documents in Opposer's possession, custody or control, which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Response to Request No. 25: Opposer objects to this request calling for all documents as being unduly burdensome, which would require that virtually all of Opposer's packaging and marketing materials be produced. Subject to the General Objections, as well as the terms of the Protective Order entered in this proceeding, Opposer produces herewith documents marked "Attorney's Eyes Only" as Bates Nos. A011285 through A011585. In addition, to the extent not previously produced, Opposer produces herewith representative packaging samples, which show Opposer's use of AMERICA'S FAVORITE PASTA as Bates No. A011586 through A011594. Opposer reserves the right to supplement this production as additional documents are discovered.

Request No. 26:

Produce all studies, surveys or scientific reports which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Response to Request No. 26: Subject to the General Objections, as well as the terms of the Protective Order entered in this proceeding, see the response to Request No. 25, as well as documents previously provided..

Request No. 27:

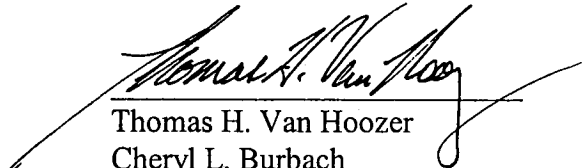
Produce all studies, surveys or scientific reports, which Opposer contends reflect the degree of likelihood of confusion between Opposer's use of the phrase AMERICA'S FAVORITE PASTA and Applicant's proposed use of Barilla - America's Favorite Pasta.

Response to Request No. 27: Subject to the General Objections, Opposer does not have any such studies in its possession, custody or control.

Respectfully submitted,

**AMERICAN ITALIAN PASTA
COMPANY**

Dated: December 6, 2005

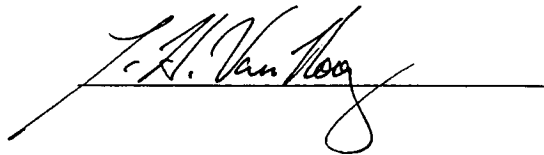


Thomas H. Van Hoozer
Cheryl L. Burbach
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108
Phone: (816) 474-9050
Fax: (816) 474-9057
Attorneys for the Opposer

CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of December, 2005, I served the foregoing OPPOSER'S RESPONSE TO APPLICANT'S THIRD SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the following:

G. Franklin Rothwell
Carla C. Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005

A handwritten signature in cursive script, appearing to read "T. A. Van Hooy", is written over a horizontal line.